No. 2641.

IN THE

United States

Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

Wilson & Willard Manufacturing Company and Elihu C. Wilson,
Defendants and Appellants,
vs.
Robert E. Bole and Edward Double,
Complainants and Appellees.

APPELLEE'S BRIEF.

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This is an appeal by defendants from an interlocutory decree ordering and granting an injunction against defendants.

Complainants filed their bill of complaint alleging the invention by complainant Robert E. Bole of the improvement in under-reamers in controversy; the filing in due form and time as required by law of an application by Mr. Bole for letters patent, the assignment of an undivided half interest in and to such invention to complainant Edward Double, and the grant, issuance and delivery in due form of law by the gov-

ernment of the United States of letters patent No. 1,080,135 on December 2, 1913, to complainants for said invention.

Complainants further alleged that the defendants, Wilson & Willard Manufacturing Company, and Elihu C. Wilson, its president and controlling stockholder and the actual director of its business and policies, were infringing said letters patent by making, using and selling underreamers embodying the said invention without the consent or allowance of complainants or either of them; and prayed an injunction to prohibit the continuance of such infringement and for the usual account of profits and damages arising out of such invasion of the patent franchise.

Defendants answered and by their joint answer asserted *only two defenses.* Defendants did not controvert that the invention covered by said letters patent was new and useful and patentable at the date of Mr. Bole's application for said letters patent, or that it had ever been anticipated. No issue as to the patentable novelty or patentable invention was raised by such answer. On the contrary, defendants rested their defense solely upon the two propositions:

First: That defendant, Elihu C. Wilson, was the inventor of the invention covered by said letters patent and that the application for letters patent by Robert E. Bole was fraudulent; that the patent in suit was void for the reason that defendant, Elihu C. Wilson, and not Robert E. Bole, was the original, first and sole inventor thereof.

Second: That as a part of a settlement of an account between Mr. Bole and the defendants, Mr. Bole did

> "withdraw and waive any claim or right of invention or interest whatsoever pertaining to the invention being said subject-matter of said pretended letters patent, and did covenant that in no way would said Robert E. Bole injure or cause injury to or damage or cause damage to said defendants in any manner whatsoever with relation to said invention the subject-matter of said pretended letters patent; whereby said complainant Robert E. Bole and said complainant Edward Double, assignee of one-half interest in and to said invention, if the allegations thereunto in the bill of complaint herein be true, is and are estopped from asserting any pretended right or claim, as in the bill of complaint herein may be set forth, against said defendants herein or either of them."

This case came on for hearing before His Honor Judge Oscar A. Trippet at Los Angeles in open court under the new equity rules, and the testimony of all the witnesses (except one) was taken in open court and Judge Trippet saw the witnesses, observed their demeanor upon the stand, heard their testimony, and in the majority of cases, as the record shows, himself questioned each witness in regard to one or more statements of the witness's testimony. The trial consumed six court days.

The issues tried were issues of fact and were determined by His Honor Judge Trippet after hearing the conflicting evidence of the witnesses on behalf of

the parties. He had a full opportunity to observe the witnesses, the manner of giving their testimony, and to judge of their credibility.

It will be found that there is no evidence whatever to support the second defense.

The first defense, to-wit: that Elihu C. Wilson, and not Robert E. Bole, was in fact the inventor of the improvement in underreamers covered by the letters patent in suit, *is a question of fact.*

> "A question of invention is a question of fact, and not of law."
>
> Walker on Patents, section 42;
>
> Poppenhusen v. Falkes, 5 Blatch. 49;
>
> Shuter v. Davis, 16 Fed. 564.

As will be pointed out hereinafter that question of fact has been decided by His Honor Judge Trippet after considering the conflicting testimony of the witnesses and after observing their demeanor upon the witness stand. It is undoubtedly the purpose of the new rules in equity, providing as they do for the hearing of equity cases upon the testimony of witnesses educed in open court, that the trial judge shall have a better opportunity to observe the character and demeanor of the witnesses and be in a better position to judge as to their credibility, etc. In this respect a final hearing or trial in equity under the new rules is in all respects like unto a trial of an action at law without a jury and the findings of fact of the trial judge are entitled to the same weight. In any event, however, the findings of fact of the lower court will

not ordinarily be reversed upon appeal where there is conflicting evidence. In fact the findings of fact of the lower court are presumptively correct, and, as stated by the Circuit Court of Appeals of the 8th Circuit in *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 659-665, "ought not to be reversed unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the facts."

See, also:

National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 716;
Mann v. Bank, 86 Fed. 51, 53;
Tilghman v. Proctor, 125 U. S. 136;
Kimberly v. Arms, 129 U. S. 512;
Furrer v. Ferris, 145 U. S. 132, 134;
Warren v. Burt, 58 Fed. 101, 106;
Plow Co. v. Carson, 72 Fed. 387, 388;
Trust Co. v. McClure, 78 Fed. 209, 210;
Exploration Co. v. Adams, 104 Fed. 404, 408.

The issue tendered by the first defense is: Was Elihu C. Wilson and not Robert E. Bole the inventor of this invention? The letters patent issued to complainants are *prima facie* evidence that Robert E. Bole was the inventor and it is for him who contends to the contrary to prove such contention beyond reasonable doubt, for in case of doubt the *prima facie* presumption of the patent resolves the question in favor of the validity of the grant. This *prima facie* presumption

of the validity of patent and that Mr. Bole was the inventor follows clear through the attack on the validity of the patent and places the burden on defendants of proving beyond reasonable doubt the truth of their contention.

That defendants have failed utterly to sustain this burden of proof is apparent from the remarks of Judge Trippet when deciding this case in the trial court. Judge Trippet, after hearing the testimony given and observing the demeanor of the witnesses on the stand, says:

> "I am thoroughly convinced that the complainant, Bole, invented the key in controversy, and is justly entitled to a patent. If there had not been a patent issued in the case, or if the patent had been issued to the defendant, I should decide this case in favor of the complainant, Bole."
>
> "I have not the slightest doubt about how to decide this case, and I decide it in favor of the complainants."

It is apparent that the trial court did not decide the case upon a failure of the proofs on behalf of defendants to measure up to the burden cast by law upon them, but upon the conviction, without the slightest doubt, that the testimony of the witnesses proved that Mr. Bole was the inventor. In reviewing such decision, it is seen that the burden on this appeal on the defendants-appellants is an extremely heavy one. Not only must they ask this court to say,—without seeing the witnesses or having any opportunity of judging from their appearance or demeanor or their apparent frank-

ness or lack of frankness, or their hesitancy, the weight to be given to their respective testimony,—that not only was the trial court in error in being "thoroughly convinced" without "the slightest doubt" that complainant Bole was the inventor, but that beyond reasonable doubt the only conclusion to be drawn from the evidence is that Mr. Wilson and not Mr. Bole is the inventor. That there is evidence upon which to sustain the finding of fact of the trial court cannot be denied. In fact there is hardly a probative fact as to which there is not conflicting evidence and this court is asked to reverse the lower court's finding of fact and say that such lower court erred in believing the witnesses it believed after both seeing the witnesses and hearing their testimony given.

That the correct rule of law as to burden of proof is, as herein stated by complainants-appellees, clear.

In Ross v. Montana Union Ry. Co., 45 Fed. 425, Judge Knowles sitting in the District of Montana in charging the jury said:

> "It is for you to determine from the evidence whether or not he is the original and first inventor of this car. He has introduced his patent, derived from the United States, for this car. This patent affords, *prima facie,* a presumption that the plaintiff, Ross, was the original and first inventor of this car. The defendant may over throw this presumption, but in order to do this it must establish that he is not such first and original inventor by evidence so strong and convincing that you can say that he is not the first and original inventor of this car, to a moral certainty. A moral certainty

is that high degree of probability, though less than absolute assurance, that induces prudent and conscientious men to act unhesitatingly in matters of the gravest importance. This instruction as to moral certainty is equivalent to the instruction that is generally given in criminal cases, that a jury must be satisfied beyond a reasonable doubt of the guilt of a defendant, and, if there is a reasonable doubt in the mind of the jury, it must then be resolved in favor of the defendant; and in this case the reasonable doubt that may be in the minds of the jurors as to who is the first inventor should be given to the one who has the patent for the invention. If you are not satisfied to a moral certainty of it, that is beyond a reasonable doubt, that the plaintiff is not the inventor, then you should find that he is the first and original inventor."

This court, then consisting of Circuit Judge McKenna and Judge Ross and Knowles, in *Hunt Bros. Fruit Packing Co. v. Cassidy,* 53 Fed. 260, said:

"The evidence given by Cassidy concerning the Alden dryer was brought out by defendant on cross-examination. It would appear to have been an attempt on its part to make out its defense in this way. If the evidence of Cassidy had any tendency to make out defendant's defense, it was a matter for the jury to determine its weight. And they should have been able to find from it, beyond reasonable doubt, that there was no invention in his patented devices, or that it had been anticipated. Coffin v. Ogden, 18 Wall. 120; Walk. Pat. § 76."

In Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. 720, it is said:

> "The burden is on the respondent for the grant of the patent is *prima facie* evidence that the patentee was the first inventor of what he described and claimed. Seymour v. Osborne, 11 Wall. 516."

See also

Patterson v. Duff, 20 Fed. 641.

The situation is this then: the trial court found that the defendants-appellants had not sustained the burden of proof which rested upon them to prove that Mr. Bole "obtained all his knowledge and information with respect to such subject matter (the invention in issue) from the defendant herein, E. C. Wilson," as pleaded in paragraph V of the amended answer [Transcript pages 18-19]; that on the contrary the trial court was "thoroughly convinced" without "the slightest doubt" that Mr. Bole was the original and true inventor.

The issue made by the answer was not did Mr. Wilson invent or produce this improvement before Mr. Bole invented it but "Did Robert E. Bole invent it and disclose it to Mr. Wilson or did Mr. Wilson invent it and disclose it to Mr. Bole." A careful consideration of the issue as framed by the amended answer clearly shows that this is the issue raised by such answer.

The question is not one of priority of time of invention but one of fact as to whether Mr. Bole or Mr. Wilson was the inventor. There can be no claim made

under the issues of the pleadings that Mr. Bole and Mr. Wilson were independent inventors. The issue is simply which one of these two men was in fact *the* inventor.

The pleadings on behalf of defendants, the opening statement of counsel for defendants, and the testimony educed on behalf of defendants all admit that both Mr. Wilson and Mr. Bole had full knowledge of the invention at one and the same time,—if any credence is to be given to defendants' witnesses testimony. The claim on behalf of defendants is that this invention was first talked over on February 3, 1911, by Mr. E. C. Wilson, Mr. Bole, Mr. Wilson's brother W. W. Wilson, Mr. C. E. Wilcox and others. If this is believed,—and it is the basis of this defense,—then it is positively shown and admitted that Mr. Bole had full knowledge of the invention at that time. It follows if Mr. Bole was the inventor at that time, then no subsequent act on the part of E. C. Wilson could make him the first and true inventor and it becomes immaterial, so far as establishing whether Mr. Bole or Mr. Wilson was the original, first and sole inventor, what thereafter either Mr. Bole or Mr. Wilson did with the invention. Under the issues and under the evidence on behalf of defendants either Mr. Bole or Mr. Wilson was on February 3, 1911, the inventor. One or the other of these men, *according to defendants' pleadings and testimony,* secured all his knowledge and information with respect to this invention from the other at that time. If this premise is correct then it follows that the contention made in this court that the manufacture and sale of

underreamers by the defendants for twenty-two months prior to the date of the filing of the application for patent by Mr. Bole is an anticipation or that any question of diligence is at issue are founded on error. How can it be found as a matter of fact or law that anything that happened after this date (taking defendants' contentions as to the February 3, 1911, conference as a fact, for the purpose of argument) could constitute Mr. Wilson an original inventor or Mr. Bole an original inventor if at such time the invention was explained to him by the other? In other words, if Mr. Bole explained this invention to Mr. Wilson at that time, then nothing thereafter happening could make Mr. Wilson the original inventor. If Mr. Wilson at that time explained this invention to Mr. Bole then nothing that either party did thereafter or could do thereafter could make Mr. Bole the original inventor. It follows, therefore, that defendants must prove that Mr. Wilson was on that date the original inventor and on that date explained this invention to Mr. Bole or this whole defense falls.

There is no pretence on the part of defendants that at any other time Mr. Wilson was the original inventor or that he made and used underreamers embodying the invention without Mr. Bole's knowledge. The defense is absolutely predicated on this alleged explanation by Mr. Wilson to Mr. Bole on that date and if it fails as to such explanation by Mr. Wilson or fails to show that at that date Mr. Wilson and not Mr. Bole was the original inventor, then the defense fails utterly, as it is admitted by defendants that there was an ex-

planation of the invention at that time. It is not in the mouth of defendants to claim that if their testimony is found false as to there having been an explanation of the invention at that time, they should be believed in the denials by the impeached and contradictory testimony of E. C. Wilson that Mr. Bole explained the invention to Mr. Wilson prior to that date. Any contention that Mr. Wilson was an independent or original inventor of this subject matter, unless it is founded upon this alleged conference of February 3, 1911, and the alleged explanation at that time of the invention by Mr. Wilson or Mr. Bole, is utterly impeached by the testimony of Mr. E. C. Wilson himself. Any such contention is utterly inconsistent with the theory upon which the case was tried by defendants and utterly at variance with the testimony of Mr. E. C. Wilson. Therefore, again complainants reiterate the assertion that the sole issue is one of originality of invention as between Mr. Bole and Mr. E. C. Wilson and that the making, use or sale of underreamers embodying the invention throws no light whatever upon this issue and does not raise any other issue of law or fact to be determined.

If Mr. Wilson explained this invention to Mr. Bole then Mr. Bole could not thereafter become the original and true inventor. Conversely if Mr. Bole explained the invention to Mr. Wilson, nothing that Mr. Wilson could thereafter do could make him the original, first or true inventor.

The sole issue then is who was the inventor?

We have already seen that the burden of proof on this issue is upon the defendants-appellants. And we assert that the court must find that this alleged conference was called on February 3, 1911, by Mr. E. C. Wilson and that he prior to that time was the original, first and sole inventor or that the defense utterly fails. For the sake of argument complainants might safely admit that such a conversation took place. That no such *conference* was called and that Mr. E. C. Wilson is drawing upon his imagination that he called such a conference for such purpose is established beyond the peradventure of doubt. It is denied by Mr. Wilson's brother W. W. Wilson, Mr. C. E. Wilcox, Mr. Willard and Mr. Bole,—each and every one of the men Mr. E. C. Wilson claims to have called to such conference. Defendants' counsel may urge that Mr. E. C. Wilson may have been mistaken as to calling such a conference and that the entire talk was an accident and that the participation of any of the others in any such a conversation was merely a coincident,—an accidental happening. This is utterly at variance with the testimony of E. C. Wilson, who has reiterated time and again that he called a conference of these men to discuss this matter. If Mr. E. C. Wilson is wrong as to this fact of his having called a conference of these men to discuss this matter. If Mr. Wilson is for this purpose, he is equally clearly shown to be in error as to the other facts of the alleged conference or conversation. The entire unreliability of his testimony as to such conference or conversation is conclusively

shown by this denial of the manner of its inception. *This is extremely significant as it is on Mr. E. C. Wilson's own testimony alone and uncorroborated* that it is sought to show that he in fact ever had a conception of the invention prior to this conference or that he made the sketch which is alleged to have been in his hands at such conference. The vital fact, the one fact which determines this issue, did Mr. E. C. Wilson conceive this invention before this conference and did he make the sketch which he had at this conference, rests solely upon his own testimony. He does not claim to have explained the invention to anyone prior to this alleged conference and no one testifies that he saw Mr. E. C. Wilson make the sketch. It is not produced. No one testifies that he remembers that it was in Mr. E. C. Wilson's handiwork. It is shown that both Mr. Wilson and Mr. Bole were making sketches before any of the witnesses observed anything of this conversation or heard any of it. The point we make is that so far as the testimony of either Mr. Willard, Mr. W. W. Wilson or Mr. C. E. Wilcox goes, the alleged sketch in the possession of Mr. E. C. Wilson at the time W. W. Wilson and C. E. Wilcox testify they heard conversation, may have been made by either Wilson or Bole. The burden of proving that E. C. Wilson made that sketch and made it as his independent conception of this invention rests upon the defendants and upon such issue we have only the uncorroborated testimony of Mr. E. C. Wilson. He is impeached by the testimony of his own witnesses as to the alleged calling of such conference.

His testimony is positively shown to be false in regard to this material fact. Why, then, should he be believed as to his assertion that prior to such conversation he had conceived the idea of this invention and that he made the sketch which he claims to have had in his hand at the time a part of the conversation between Mr. Bole, Mr. Willard and himself was accidentally overheard by his brother W. W. Wilson and Mr. Wilcox? If the lower court, having observed his demeanor on the stand and having heard his testimony given, refused to believe his uncorroborated testimony that he had conceived this invention prior to this conversation and that he made the sketch which he had in his hand when he stepped back from the shipping desk, is this court to say that unquestionably the trial court was wrong? Which is and was in the better position to judge of the credibility of the witness?

It is very significant that the one most vital fact of this defense rests on the uncorroborated testimony of Mr. E. C. Wilson. To support the defense it must be established that Mr. E. C. Wilson and not Mr. Bole was the originator or inventor. The defense rests upon the impeached testimony of Mr. E. C. Wilson for its two most vital facts. If these two facts be not proven then the defense falls.

We have only the testimony of Mr. E. C. Wilson that he conceived this invention before this conversation. We have only his testimony that he made the sketch. The testimony of his brother goes no further than that E. C. Wilson had a sketch in his hand when he, W. W. Wilson, came up to where he says E. C.

Wilson, Mr. Bole, Mr. Willard and Mr. C. E. Wilcox were talking. The testimony of Mr. Wilcox shows that he does not know who made the sketch. He so states. Mr. Wilcox testifies that he from a distance saw E. C. Wilson, Mr. Bole and Mr. Willard around the shipping desk in the back of the shop and that they were bending over the desk. That both E. C. Wilson and Mr. Bole had pencils in their hands and were making sketches. That he took no part in the conversation and was not a party to it. That after these three had been talking for some time E. C. Wilson stepped back from the desk with a sketch in his hand and said: "Oh, I know how to get it in there, but I don't know how to get it out." Mr. Bole says, "Pry one end of it up and drive it out." [Tr. p. 27.] Mr. Wilcox unequivocally states that he did not know and does not know whether it was Mr. Bole or Mr. E. C. Wilson who made the sketch that Wilson had in his hand. [Tr. p. 258.] Mr. Wilcox was called on behalf of the defendants and was one of their employees.

Naturally it is to be expected that the testimony of W. W. Wilson will be as favorable as possible to his brother. Yet on this most vital question of whether E. C. Wilson had any conception of this invention prior to this alleged interview of February 3, 1911, and on the attendant almost equally important question of whether E. C. Wilson made the sketch he is alleged to have had at this conversation, W. W. Wilson does not support his brother's testimony. W. W. Wilson says that as he was passing through the shop he stopped and talked with Mr. Knapp a few minutes;

"then it came to my attention that Mr. Willard, Mr. Bole and Mr. E. C. Wilson *and Mr. Wilcox* were standing near one of the shapers, near the back shaper in the shop, looking at an underreamer which was lying on the floor. And so I stepped up to the conference and saw there my brother had a sketch on one piece of paper, *or several sketches on two or three pieces of paper,* showing different types of keys." [Tr. p. 273.] "I was not invited into the conference." [Tr. 293.] He admits that he was not present when the conversation between Mr. Bole, Mr. Willard and Mr. E. C. Wilson started and does not know how long they had been talking before he joined them. [Tr. p. 292.] If then reliance is to be given to the testimony of defendants' witness, Wilcox, that the sketch was made at the shipping desk it is apparent that Mr. W. W. Wilson can know nothing concerning who made the sketch. The utter unreliability of the memory of Mr. W. W. Wilson and the lack of dependence to be given to his testimony is shown by the contradictory character of his testimony and by the fact that he testified that there was no contract in writing in settlement between the Wilson & Willard Mfg. Company and Mr. Bole in 1913 when the settlement of the Bole Pump matters was arranged and the fact that after giving such testimony the original of such contract in writing was presented to him and he was forced to admit that he had signed as a witness to such contract. [Tr. pp. 291-292.] In testifying to such matters he was only searching his memory in regard to an occurrence which happened a little over a

year prior to giving his testimony. In testifying in regard to this sketch and this conversation he was testifying to matters that are alleged to have occurred another two years prior to that, and as to which the further lapse of time had dimmed his recollection.

The conflict of the testimony of defendants' witnesses as to this sketch is further exemplified by reference to Mr. Wilcox's testimony that after Mr. E. C. Wilson turned away from this shipping desk over which he, Bole and Willard had been "huddled" no changes were made in the sketch nor were any additions or alterations made in such sketch [Tr. p. 257, also p. 263], while Mr. W. W. Wilson, although asserting that Mr. Wilcox was present and took part in the conversation, testifies that alterations were made in the sketch by E. C. Wilson. [Tr. 294.] While W. W. Wilson has the impression and attempts to state positively that his brother E. C. Wilson had several sketches in his hand of different shapes of keys at this time [Tr. p. 294], Mr. Wilcox point blank says there was only one that he saw. [Tr. 259 and 263.] W. W. Wilson testifies that he joined Mr. E. C. Wilson, Mr. Bole, Mr. Willard and Mr. Wilcox and then saw these sketches and heard this conversation. Mr. Wilcox testifies that he was not a party to the conversation at all and that after Mr. E. C. Wilson turned away from the shipping desk with the sketch in his hand and said to Mr. Bole, "Oh, I know how to get it in there, but I don't know how to get it out," and Mr. Bole said "Pry one end of it up and drive it out." [Tr. p. 248.] "They passed out of my hearing, and that

was about all I heard at that time." W. W. Wilson testifies that he joined E. C. Wilson, Mr. Bole, Mr. Willard, Mr. Wilcox and possibly Mr. Knapp and then heard this same conversation and even says that Mr. Wilcox said "Yes, pry it out." [Tr. p. 274.] Mr. Wilcox says he took no part in the conversation whatever.

There is clearly a most marked contradiction in this testimony. *But* there is a total failure of any testimony whatever by either Mr. Wilcox or W. W. Wilson which will deny that the sketch had been made by Mr. Bole or that will establish that the sketch had been made by E. C. Wilson. Both Wilcox and W. W. Wilson admit that they did not hear all the conversation nor the beginning of the alleged conversation. Neither claims to have seen the sketch made. Neither therefore was in a position to say that E. C. Wilson explained the key to Mr. Bole or to say that Mr. Bole explained the key to E. C. Wilson. The testimony of these witnesses, C. E. Wilcox and W. W. Wilson, must, from their lack of opportunity to have heard the conversation, be totally silent on these vital questions of who explained the key invention to the other and who made this sketch. There is a total absence of any corroboration of E. C. Wilson's claim that he made the sketch or that he explained the invention to Mr. Bole at this mythical "conference" which he says he called of Mr. Willard, Mr. Bole, Mr. W. W. Wilson, Mr. C. E. Wilcox and perhaps Mr. Knapp, *and which is denied by every one of these men.* The burden of proof is on defendants. Not on complainants.

Defendants admit that Mr. Wilson and Mr. Bole both were in possession of this invention on February 3, 1911, and talked together of it. The burden is on the defendants to prove that E. C. Wilson originated it and disclosed it to Mr. Bole. Merely showing that both Wilson and Bole knew of it February 3, 1911, proves nothing as to whether Wilson or Bole was its author.

On such conflicting testimony how can this court say the trial court was undoubtedly wrong in its finding of fact? Who knows to what extent the manner and demeanor of the respective witnesses indicated their frankness and truthfulness?

The testimony of Mr. E. C. Wilson, W. W. Wilson and C. E. Wilcox, called by defendants, is an admission on the part of the defendants that both Mr. E. C. Wilson and Mr. Bole on February 3, 1911, were in possession of this invention. One or the other of them was the inventor at that time or prior to that time. No act of either of them subsequent to this admitted date when the invention was discussed by them can change the fact as to who was the inventor. Either Mr. E. C. Wilson derived his knowledge of the invention from Mr. Bole and by no act could thereafter become the original and true inventor or he was the true and original inventor at that time and disclosed the invention to Mr. Bole.

Complainants therefore repeat that except to enable the court to judge the trustworthiness of the testimony of the witnesses and the weight to be given to their testimony, the subsequent acts of any of the parties

in building underreamers is immaterial. It might throw light on the weight to be given to their testimony but it cannot and does not change their rights or characterize by such subsequent acts either of them as the true and original inventor or discoverer of this invention.

The testimony of the witnesses for defendants proves beyond doubt that Mr. Bole was in possession of the invention as early as February 3, 1911. Unless it proves that he derived this knowledge of the invention from E. C. Wilson, the defendants' case falls. Not only has a patent been issued to complainants, raising a *prima facie* presumption that Mr. Bole was the original and true inventor but it is thus conclusively shown that he was in possession of the invention prior to the commencement of making by Wilson of any underreamer embodying the invention. In other words, complainants insist that the testimony shows that either Bole communicated the invention to E. C. Wilson or E. C. Wilson to Bole before the commencing of the making of the first underreamer embodying the invention, and that if the defendants are to succeed in their defense they must prove that Mr. Wilson was the first to conceive this invention, that he was the originator of it, and that he explained it to Mr. Bole.

The record in this case is a full and direct admission on the part of E. C. Wilson and of his witnesses that the invention was fully discussed between E. C. Wilson and Mr. Bole as early as February 3, 1911. If Mr. Bole was the originator or inventor at that time

then Mr. Wilson derived his knowledge of the invention from Mr. Bole and no subsequent act of either party could change that status and make Mr. E. C. Wilson the one who first conceived the invention and explained it to Mr. Bole. To prove this latter is the burden assumed by defendants by their answer. The trial court not only held that defendants had failed to prove this but that the testimony "thoroughly convinced" without "the slightest doubt" the trial court that Mr. Bole was the inventor and that Wilson derived his knowledge of the invention from Mr. Bole.

There is no dispute but that Mr. Bole never built an underreamer embodying this key invention. The Wilson underreamer was manufactured by the defendant Wilson & Willard Manufacturing Company for defendant E. C. Wilson under the monopoly of the patent to E. C. Wilson granted July 31, 1906, number 827,595. [Tr. p. 740.] This patent covers broadly the general interrelation of the parts, while the invention in dispute in the case at bar is merely an improvement in the means for assembling and holding in assembled position the spring actuated rod or tee upon which the reaming bit or cutters are mounted and by which they are operatively connected with the body of the device. The present invention is a substitute for the block 7 and dowel pins 8 of the Wilson patent. Without a license from Mr. E. C. Wilson Mr. Bole could not make underreamers. The patent in suit is for an improvement and is dominated, so far as the Wilson type of reamer is concerned, by the Wilson patent. Mr. Bole was in equally as impossible a posi-

tion with respect to the so-called "double" or "union" reamer. It was covered by patents. He could not use his invention in either of these constructions of reamers without infringing patents held by others. Mr. Bole's only chance to derive any advantage or profit from his invention was in licensing either the defendants or the owners of the "double" patents to use his invention. If he was satisfied to permit Mr. Wilson to thoroughly try out the invention before settling with him on a royalty, he had a perfect right to do so. In fact it would not take away his right either to a patent or to stop Mr. Wilson's continuation of the use of his invention whenever he, Bole, saw fit to notify him to stop the use of the invention, for Mr. Bole to permit Mr. Wilson at his, Mr. Bole's, will to freely use the invention. It was at most a gift privilege,—without consideration,—and a license which Mr. Bole could revoke at pleasure. From its use Mr. Wilson acquired no rights. To hold that defendants acquired any right to the invention or to its free use forever under such circumstances would simply be to hold that the strong may take that which belongs to the weak, and neither the law nor equity will afford him a remedy. This is what the trial court meant when it said:

> "He (Bole) was not in a situation to put it into practical use until his relations with that company were severed. He applied to the defendant to put the key into use."

The relations referred to as existing between the Wilson & Willard Manufacturing Company and Mr. Bole were not those of employer and employee, during

1911 or 1912. The relations were those of joint interest in the manufacture and sale of the Bole pump, which pump was manufactured by the Wilson & Willard Company and for and on behalf of Mr. Bole, the Wilson & Willard Company deriving the manufacturers' profit and Mr. Bole the sales profit. In law they were doubtless partners in that business at that time. Mr. Bole was not in financial condition to manufacture underreamers and he had no underreamer to manufacture. The invention in issue is merely an improvement in the means for holding the operative parts of an underreamer in working relation and permit ready assemblance and quick and easy taking apart. The substantial working parts of the underreamer were covered by the Wilson patent.

WHY DID THE LOWER COURT NOT BELIEVE MR. E. C. WILSON'S TESTIMONY THAT HE MADE THE SKETCH AND WAS THE INVENTOR?

As we have seen there is produced no testimony of any other person, than E. C. Wilson himself, tending to show any knowledge, on the part of any of the witnesses produced on behalf of the defendants, whether Mr. E. C. Wilson was the originator of this invention or whether *he made* the sketch which he is alleged to have had during this conversation of February 3, 1911, or what conversation or conversations he had previous thereto with Mr. Bole and Mr. Willard, or with Mr. Bole alone, in regard to this invention.

On direct examination Mr. E. C. Wilson says that *"I called* some of the boys together" *"in that confer-*

ence—there was Mr. Knapp, I believe, Mr. Wilcox, possibly my brother W. W., and Mr. A. G. Willard and Mr. Bole. We were *all* in conference over this key proposition." [Tr. p. 106.] On this statement we have already seen that he is contradicted by the testimony of Mr. Wilcox and by the testimony of his brother W. W. Wilson. Mr. Willard says he does not remember any such conference. And Mr. Knapp was not there.

E. C. Wilson's version of the conversation is totally different from that of either his brother, W. W. Wilson, or of C. E. Wilcox. E. C. Wilson admits that Mr. Bole suggested to pry it out and says that he said, "Very well. We will admit that it can be pried out, but won't it give so much trouble in doing so that it will probably condemn it and the drillers won's use it? He says, 'No; I can devise a tool which will pry it out.' I said, 'I can devise a tool that will pry it out, but I think it will give us a good deal of trouble.' After further discussion *the boys agreed* with me that that was the better style of key and it was well worth trying, and with that point settled we proceeded to make up a single-piece key as I desired. That was the genesis of that key." [Tr. p. 107.]

On page 117 of the transcript is found E. C. Wilson's answer when he again reiterates that *all* of these parties were present "at that conference."

On cross-examination Mr. E. C. Wilson says that it seemed to him that he left the office in company with either Mr. Willard or his brother and went into the shop or possibly Mr. Bole was with them at the time

they walked back to the shop and he announced his intention to change over the reamer. [Tr. p. 177.]

On page 176 of the transcript Mr. E. C. Wilson says it might have been longer than two minutes that he had talked with Mr. Willard and Mr. Bole before his brother W. W. Wilson joined them.

In his testimony in the Interference in the United States Patent Office we find a decided difference. His testimony in the Interference was given a year prior to the trial of this case. Then Mr. Wilson testified, "One evening I decided to obtain the opinion of some of the men in the shop in regard to the relative merits of the different types of keys which I had evolved in my mind. As I have previously testified, *I called* Mr. Willard and Mr. W. W. Wilson and Mr. C. E. Wilcox and Mr. R. E. Bole, and it seemed to me that I had Mr. Knapp in that conference also." [Tr. p. 723.] Further on he says, "Now, these gentlemen all agreed that the single-piece key was the better type." [Tr. p. 724.] Yet as we have seen Mr. C. E. Wilcox testifies that he was not a party to and took no part in that conversation. W. W. Wilson says he was not called or invited to such "conference."

Remembering that Mr. Wilcox says he first saw Mr. E. C. Wilson, Mr. Willard and Mr. Bole huddled over the shipping desk in the rear of the shop and after that E. C. Wilson stepped back away from the desk with a sketch in his hand and made the remark, "Oh, I know how to get it in there, but I don't know how to get it out," and Mr. Bole said "Pry one end of it up and drive it out" [Tr. p. 248], and then Mr. E. C.

Wilson passed close enough to him, Wilcox, to enable him to see the sketch as he went by and that he, Wilcox, took no part in the conversation whatsoever, and that W. W. Wilson and Mr. Knapp were talking together at a point still further away, it is to be noted that E. C. Wilson testifies that according to his recollection he was NOT at the shipper's desk PRIOR to this conversation between Mr. Bole and himself which he has detailed; from his testimony on cross-examination he would have us believe that this conversation in which he says Mr. Wilcox and his brother, W. W. Wilson, took part, took place *before* they (E. C. Wilson, A. G. Willard and Mr. Bole) went to the shipper's desk; that according to his recollection they just loitered over toward the shipper's desk and that no sketches were made there. [Tr. pp. 171 and 173.]

At another point in his testimony he says that it was in the latter part of the conference that A. G. Willard, Mr. Bole and he were at the shipper's desk and that they were not, prior to the conversation which he repeated, together at this shipping desk discussing anything or making any sketches. [Tr. pp. 168, 169.]

In one breath E. C. Wilson testifies that he called a "conference" of these men mentioning his brother in particular and that they were all together when this conference took place and that they all took part in the discussion. In another breath he says that he does not know just when it was that his brother arrived at such conference; that he had been talking with Mr. Willard and Mr. Bole for some time before his brother arrived; in another breath he testifies that his brother

walked with him from the office into the shop prior to this converstion and was with them at the start of the conversation. Then [Tr. p. 167] he says that Mr. Willard, Mr. Bole, Mr. Knapp and his brother, W. W. Wilson, were present when the talk started; then that he is not positive whether his brother was there at the commencement of the talk. He does positively state that after they had been discussing the matter a little while he asked C. E. Wilcox about it. [Tr. p. 167.] Then although he has positively stated that this conversation took place before Mr. Willard, Mr. Bole and himself went to the shipping desk he testifies [Tr. p. 168] that he does not remember whether they were at the shipping desk before the conversation which he has detailed took place; (the conversation took place over the underreamer bodies lying on the floor of the shop). Then again in the next breath he states positively that he was not at the shipper's desk prior to such conversation.

A reading of the cross-examination of Mr. E. C. Wilson demonstrates conclusively that his memory is far from clear as to any one of the attendant circumstances of this alleged conference which he so glibly asserts he called and which calling is denied by each of the parties supposed to have been called to such conference. Not one of them admits that Mr. Wilson called or asked him to become a party to this conference. Mr. Wilson's testimony on cross-examination conclusively shows that his memory is utterly unreliable and uncertain as to every material fact and his testimony necessarily fails to carry conviction. Appellees

feel safe in asserting that his testimony taken as a whole does not show an accurate *memory* of the things he attempts to assert as facts. On the contrary it shows that he is testifying not from what he distinctly remembers, but as to the things which he thinks must have happened and must have been the facts, reasoning from deduction and not testifying from memory. There is the most marked discrepancy between Mr. Wilson's testimony and that of the men called to corroborate him and this discrepancy exists in regard to every fact save and except that Mr. E. C. Wilson admitted after there had been conversation that he did not know how to get the key out and that Mr. Bole told him how,—said pry one end of it up and drive it out.

As we shall show hereafter there was positive proof produced that Mr. Bole had conceived this invention in September, 1908, and had communicated the same, by a written order for an underreamer embodying the invention, to the defendant company. Is it not consistent with human experience that the immediate and unhesitating statement of Mr. Bole that this key could be removed by prying one end of it up and driving it out (which is the method of removing it as used even to this day) was made by Mr. Bole because of a superior and prior knowledge of the device?

Is it not a fair inference to draw that if any such conversation ever took place, the sketch which Mr. Wilson held in his hand at the time was a sketch which Mr. Bole had made and was a part of the explanation by Mr. Bole to Mr. Wilson at the shipping

desk and that Mr. Wilson when turning away from the desk saying: "I can see how I can get it in but I can't see how I can get it out," actually admitted that he was talking about Mr. Bole's suggested key invention which had been then explained to him and discussed between them and was asking for a further explanation as to how such key could be removed? It is admitted that Mr. Bole knew how to remove such a key and it is admitted that Mr. Bole disclosed how to remove the key. If we are to believe this story at all it would seem that Mr. Wilson had in his hand a sketch of what had been suggested to him by Mr. Bole; that he, Mr. Wilson, was satisfied that *the thing* shown in that sketch would do the work and could be got into place into the reamer but that he had not yet received from Mr. Bole sufficient information to convince him how such key or device could be used practically, i. e., could be removed when it was desired to remove the bits, and that he was seeking further information from Mr. Bole when he made the remark, "I can see how I can get it in but I don't see how to get it out."

Yet it is on the testimony of the defendant E. C. Wilson alone that defendants must rely to prove that E. C. Wilson was the originator of this invention; that he had conceived this key invention before this conference; and that he, E. C. Wilson, made this sketch of the invention and explained it to Mr. Bole. Of these two asserted facts there is no corroborating evidence produced by defendants. Both are denied by Mr. Bole. Yet it is absolutely necessary that the court

shall find, first: that E. C. Wilson was the one who first conceived or thought of the use of the single-piece key in this relation; and second, that it was E. C. Wilson and not Mr. Bole who made the sketch,—particularly that it was Wilson's explanation to Bole,—not Bole's explanation to Wilson.

The testimony of C. E. Wilcox certainly is consistent with either Bole's being the author of the sketch and it being Bole's explanation to Wilson, or with Wilson's being the author and explainer to Bole. On this crucial fact Mr. Wilcox admits he was not in a position to know the facts. The testimony of W. W. Wilson shows that he was equally ignorant of these facts. The conversation had progressed sometime before he joined in it and the sketch had been made before he observed the parties talking.

The contradiction and impeachment of E. C. Wilson's testimony is complete as to every fact that can throw the slightest light upon whether he was the originator or whether he received his knowledge from Mr. Bole.

Mr. Wilson says: "It is my recollection that the sketch was made up on a piece of brown paper in the same manner that this tee is made up." (Referring to the sketch he claims he gave to Mr. Knapp as a part of the instructions for making over reamer #120.) In testifying in the Interference proceeding in the U. S. Patent Office, E. C. Wilson refers to this mythical sketch and to its delivery to the foreman, Mr. Knapp, as follows:

"after I had made my sketch of this key and turned it over to the foreman to manufacture the key." [Tr. p. 726.]

Mr. E. C. Wilson also says: "The key was made up, probably, from the one (sketch) I showed the boys at the time, one of these original sketches." [Tr. p. 108.] This sketch, if any such ever existed, would have formed a part of shop order 6904 and would have been found attached thereto in the same manner as the sketch for the slotted tee. It has never been produced and never existed. The custom of the shop. The fact that the workmen were furnished such sketches and drawings to work from. The fact that the workman would require the dimensions all indicate some sketch or drawing was made. Mr. Bole testifies he made the sketch of the single-piece key that the workman used. Mr. Rydgren testifies he had a sketch. [Tr. 689.]

Mr. Knapp, called by defendants and employed as foreman of defendants' shop, says:

"Mr. Wilson took me over to the side of the shop near a post where this reamer 120 was standing and explained to me that he was going to try a 1-piece key in this reamer. And at that time he took a pencil and drew on the palm of his hand a sketch of this key." [Tr. p. 201.]

"Q. Did Mr. E. C. Wilson at any time give you a sketch of a single-piece key that was to be made and used in reconstructing this reamer 120 otherwise than as the rough indication of it on his hand?

A. Not that I remember of." [Tr. p. 224.]

Mr. Knapp testifies that it was "possibly a day, not more than that" after Mr. Wilson made this sketch on his hand before work was started on remaking reamer 120. [Tr. p. 120.]

E. C. Wilson testifies that he dictated the shop order (6904) for remodeling this reamer 120 either the same day or next day following this conference with Mr. Bole, Mr. Willard, Mr. Wilcox and Mr. W. W. Wilson. The sketch for the tee formed a part of such shop order. It is significant of the utter unreliability of his testimony, and doubtless so impressed the trial court, that this shop order does not in any manner refer to this key. The shop order reads:

> "Change 8" reamer 120, as follows:
> Anneal same & remill to standard
> size 8" cutters.
> Bore out a hole for spring to 4"
> diameter.
> Make special 7/16"x3/4"x18" spring.
> Put in bottom bolt.
> Equip with extra heavy slotted T
> of new type, same to be made of
> nickel steel." [Tr. p. 805.]

This order specifically refers to every detail of change to be made in the reamer *except it is absolutely silent as to any key or single-piece key.* The sketch for the "extra heavy slotted T of new type" is shown on page 803 of the transcript and numbered 7056. ("A subdivision of the original order," E. C. Wilson [Tr. p. 94.].) This most elaborate system of shop orders, time and workman's slips, and shop records

show conclusively that the sketch from which and the order upon which the first single-piece key were made have not been produced. If this conclusion be incorrect,—then there is only one other:—That when shop order 6904 was made out, this invention was not intended to be placed or incorporated in the remodeled reamer and Mr. Wilson's testimony is mythical and not in accord with the shop records,—the practice of the shop, or his careful and pains-taking method of keeping records, and the incorporation of a single-piece key in this reamer was an afterthought,—after the making up of this order,—again impeaching E. C. Wilson's testimony and showing in all probability the single-piece key was first tried out in some other reamer than #120, *or the entire proposition as to the making and trial of the 1-piece key were left to Mr. Bole* and in making out shop order #6904 Mr. Wilson was only endeavoring to produce his "heavier and stronger" slotted tee; if Mr. Bole succeeded with the single-piece key that could be used. If not the old 2-piece key could be used. Doubtless as Bole suggested the one-piece key, it was left to him. He so testifies. Does not such testimony ring true in the light of the directions of shop order #6904? Neither Mr. Knapp nor any other of the workmen even pretends he has any recollection as to these facts of the remodeling of reamer 120 *except as shown by the time slips and shop orders.*

No explanation has ever been offered by Mr. E. C. Wilson of the total silence of shop order 6904 as to this particular key invention which was according to

his testimony the impelling motive for remodeling reamer #120.

How far reaching is this impeachment (of Mr. E. C. Wilson's testimony that he originated the one-piece key idea and explained it to Mr. Bole), by the silence of shop order 6904, is emphasized by Mr. E. C. Wilson's testimony, corroborated by the testimony of his brother W. W. Wilson that they together worked out the proportions of the new or "heavier" slotted tee several days before this pretended or claimed explanation by E. C. Wilson to Mr. Willard, Mr. Bole, Mr. W. W. Wilson and Mr. E. C. Wilcox. Yet no mention of the single-piece key was made to the brother, W. W. Wilson, when so discussing the changes in the tee and the rebuilding of the reamer. Yet this is the story of E. C. Wilson and W. W. Wilson would have the court believe. The shop order 6904 logically follows and logically shows what E. C. Wilson was striving to do. It by silence proves that the single-piece key was the creation of Mr. Bole and at the date of E. C. Wilson's making out such order was not in E. C. Wilson's mind as a part of the changes to be made. Does not this silent witness most persuasively tell us that the single-piece key was Mr. Bole's idea and left (as Mr. Bole says) for Mr. Bole to make and demonstrate?

Another striking example of the contradictory character of the testimony of Mr. E. C. Wilson,—another impeachment of the reliability of his memory and another demonstration of the utter lack of dependence that can be placed on his recollection or testimony is the story in regard to the discovery by the workman

Houriet that this single-piece key could be removed from the reamer by simply driving a cape chisel or the tang end of a file under one end of the key and driving the key out from the other end of the key slot.

E. C. Wilson had told two totally different stories in regard to this mythical discovery and as we shall show there was an impelling reason for the remarkable switch in his testimony.

At first he testified that he did not know when this man Houriet made this discovery; that it was sometime after February 27, 1911; that he could not tell how long. It would merely be a guess on his part. [Tr. 161.] Then he states they first removed this key from reamer 120 by means of a lever. Asked as to his best recollection how long they used such lever before Houriet made this discovery he says:

"I should say it had been two or three weeks."

Asked if the lever might have been used for four weeks prior to Houriet's alleged discovery he says: "I couldn't say as to that." [Tr. p. 163.]

Examined by the trial court after the testimony had been announced as closed by the attorneys, Mr. Wilson changes his testimony to:

> "That was just at the time the reamer was first completed so it could be assembled; it was some time in the latter part of February, 1911; it was about the middle of February, I should judge, 1911." [Tr. 699.]

In this connection it should be noted that this change by Mr. Wilson in his testimony was made after he

had heard the testimony of Mr. Houriet, Mr. Bole and complainants' witness Harry Naphas and in an evident attempt to make his testimony agree with that of Mr. Houriet. It was also to avoid the fact established by documentary evidence that this manner of removing the key was well known to E. C. Wilson and others prior to February 28, 1911. The letter to J. A. Kibele [Tr. pp. 153, 154], written, dated and mailed February 28, 1911, conclusively proves that Mr. Wilson's memory was exceedingly bad when he said [Tr. p. 163] it was after February 27, 1911, and he "should say two or three weeks" after that before Houriet discovered this key could be so removed by driving the end of a chisel or file under one end. Perhaps this palpable change of his testimony and the demeanor of the defendant E. C. Wilson on the witness stand when so interrogated by the court and he so changed his testimony, was a large factor in the court's concluding his testimony was not to be relied upon.

There is a sharp conflict between the testimony of E. C. Wilson as to this discovery of the removal of this key by a chisel or the tang end of a file and the testimony of Mr. Bole and of complainants' witness Harry Naphas that Mr. Bole made this known to E. C. Wilson and showed Mr. Wilson that the key could be so removed. The trial court heard these witnesses, observed them on the stand and believed that Mr. Bole and Mr. Naphas testified truthfully. Their testimony agrees with the E. C. Wilson letter of February 28, 1911, to J. A. Kibele.

It is also significant that Mr. Knapp did not cor-

roborate Mr. E. C. Wilson's story that Knapp called Wilson's attention to this mythical discovery of Houriet's and had E. C. Wilson come out into the shop with Knapp to see how the key could be so removed. Mr. Knapp testified in the case. He was still in Mr. Wilson's employ and we have a right to expect his testimony would be as favorable to Wilson's story as possible.

Mr. Houriet testified. He says it was about the middle of February, 1911, he accidentally drove a cape chisel in and saw it raise the key up and he drove the key right out. [Tr. pp. 475, 476.] After looking over the shop slips he says it was later than February 22, 1911. [Tr. 477.] His cross-examination demonstrates conclusively he has no recollection either of the work done or the dates except as these appear on the time slips. He makes a positive misstatement of the work he did. He is contradicted and impeached as to such work by the sketch of the slotted tee [Tr. p. 803], and by the testimony of the foreman Knapp. He is impeached and contradicted by the testimony he gave in the Patent Office Interference. The change of Mr. Houriet's testimony in an effort to meet the documentary proof that this method of removing the key was known prior to February 28, 1911, is shown by reference to Mr. Houriet's former deposition.

"Q. You gave a deposition in the interference in the Patent Office in relation to this matter?

A. I think so.

Q. You were asked in that deposition the following question and gave the following answer:

'Q. 31. What did you put under it to raise it up? A. Well, just—anything that I remember that I used— I couldn't get it out very handy, and there was a file there and I drove the file in and that raised it up, and I drove it out the other way. Q. 32. How did you drive it out? A. With a hammer. Of course, the handle of the file is tapered, and by raising up the key I could drive it out.' You gave that testimony, did you? A. Yes, sir.

Q. You were asked this question on cross-examination, were you? 'XQ. 50. I suppose, Mr. Houriet, that it was after you had completed this reamer and had it assembled that you, as you say, discovered that you could remove this single-piece key from it by driving the tang end of a file under the key. Is that correct? A. No, sir. XQ. 51. When was it? A. Before that, when I was experimenting with it trying to get the key out. XQ. 52. What was the condition of the underreamer at that time? A. I had just been working on it and experimenting with that key to get it in and out. XQ. 53. And on how many different days and different times had you been experimenting in getting the key in and out prior to that time? A. That I couldn't say. It must have been a couple of days. I couldn't say just positively. It has been too long ago. But I know I worked on it.' That is a correct statement of your testimony? A. Yes, sir.

Q. That agrees with your recollection of the facts at the time of giving such deposition on September 29, 1914? A. I think it was; yes, sir.

Q. You were asked this question on cross-examination, were you? 'XQ. 61. According to

your recollection when was it that you did that last work on that reamer and made this discovery, as you say, that you could remove the key by driving in the tang end of a file? A. I couldn't tell; it has been too long ago.' That was your testimony at that time? A. Yes, sir.

Q. And that was true according to your recollection at that time of giving that testimony? A. Yes; it was as near as I can remember.

Q. You were also asked this question: 'XQ. 62. Have you any recollection whatever of the day of the month? A. No, I have not. XQ. 63. Can you tell me whether it was in January, February or March or April? A. It has been too long; I have lost recollection of that. I know the work I did.' Did you give that testimony? A. Yes, sir.

Q. You were asked this question on cross-examination: 'XQ. 81. Will you state positively that Mr. Knapp delivered that key to you? A. Well, I wouldn't say positively, because he may have told the man that forged it to give it to me as soon as he was through with it, but it was the same thing as him giving it to me. XQ. 82. You have no distinct recollection as to who it was that gave you the key at that time, have you? A. No; I couldn't say positively. XQ. 83. Have you any recollection as to who it was that forged that key? A. Yes. I can't think of his last name, though. It was a fellow that worked there. We always called him Fred Ricker, or something like that.' Is that a correct statement of your testimony given at that time? A. Yes, sir.

Q. 'XQ. 91. How many times did you have to try to get this key out of that reamer before you discovered that you could get it out by simply

driving in the tang end of a file, as you say? A. I worked at it two or three hours trying to get it out, and possibly longer than that. XQ. 92. In how many different days? A. That I couldn't say.' That is a correct statement of your testimony? A. Yes, sir." [Tr. pp. 481-484.]

Conclusively it is shown that he had no recollection whatever of what work he did on reamer 120 or when he did it. When recalled by the court [Tr. pp. 691-693] and asked if he ever showed or demonstrated to any one that the key could so be removed, he says he does not remember any one in particular except Mr. Knapp.

(Questioned by the court):

"Q. You don't remember of showing it to anybody except Mr. Knapp that you could do it that way?

A. Yes, I remember showing it to other people that come there.

Q. Well, who?

A. I can't remember their names; I didn't know them; I didn't know them by name; he would call me over to go demonstrate the reamer, to take it apart." [Tr. p. 693.]

There can be no pretense that Mr. Houriet did not know Mr. E. C. Wilson. Yet we find that there is no testimony of any one to corroborate E. C. Wilson's testimony that Mr. Knapp told him (Wilson) that Houriet had made this discovery and took Wilson out to see how Houriet was removing the key. This story then rests on Mr. E. C. Wilson's own word. Knapp

does not corroborate him. Knapp does not testify he ever even told E. C. Wilson of this alleged discovery of Houriet's. Neither does Mr. Houriet. Both E. C. Wilson and W. W. Wilson were in the court room in plain sight of Mr. Houriet while he was testifying. Yet he cannot remember ever having shown either of them that this key could be removed in this manner.

We have heretofore pointed out the remarkable discrepancy between the testimony of the various witnesses on behalf of the defendants in regard to the circumstances under which they respectively testified they became familiar with the facts to which they testified. We have seen that while Mr. E. C. Wilson, in order to impress the court with his importance and the importance of the part he played in the origination of this invention has repeatedly testified that he called Mr. Willard, Mr. Bole, Mr. W. W. Wilson, Mr. Wilcox and perhaps Mr. Knapp into conference with him in regard to this single-piece key invention that each and every one of the witnesses deny this and deny that Mr. E. C. Wilson ever requested their presence at any such conversation. We have, however, another singular thing in connection with this claim that Mr. Houriet discovered how to remove the single-piece key from the reamer with the tang end of a file or cape chisel. It is to be noted that neither Mr. Houriet nor Mr. E. C. Wilson make any pretense that the brother, W. W. Wilson, was a party to such discovery in any manner. Neither E. C. Wilson nor Mr. Knapp testified or claimed that Mr. W. W. Wilson knew anything whatever of such discovery. Mr. Houriet does not

remember ever having shown W. W. Wilson how such key could be so removed. There is not a shadow of an assertion by either Mr. Houriet, Mr. E. C. Wilson or Mr. Knapp (the only other parties who are supposed, according to the theory of defendants' case, to have known of this alleged discovery by Houriet) that the brother, W. W. Wilson, was in any manner a party to the disclosure of this discovery by Houriet to any one. In this connection it must be remembered that Mr. Knapp does not testify that he called E. C. Wilson's attention to this discovery, nor does he in any manner mention the brother, W. W. Wilson, in this connection. It is natural, however, that we should find the brother, W. W. Wilson, stretching his imagination in his attempts to corroborate the various assertions made in the testimony of Mr. E. C. Wilson. Unfortunately, however, Mr. W. W. Wilson stretches his imagination too far. He inserts himself into occurrences which, according to the testimony of the other of the defendants' witnesses, occurred without his knowledge. Perhaps this fact is one which was considered by the trial court in rejecting the testimony on behalf of the defendants. Perhaps the manner in which W. W. Wilson appeared on the stand and his demeanor influenced the court in its conclusion. It is significant that W. W. Wilson testifies in this regard as follows:

> "I was sitting in the office one day and Mr. Knapp came into the office and got myself and Mr. E. C. Wilson and told us to come out into the shop and look at that reamer. He said we

didn't need a lever to pry it out. So we went out into the shop, and Mr. Houriet, who was working on the underreamer, had found that—and he did at that time put the underreamer together, and then, with the tang of a file, drove it under one edge of the key and pried it up. He was then unable to pull the file out and leave that key with the prong sticking up on the edge or corner of the bore; and then he was able to drive the key out the other side. That is the way he dismantled the reamer at that time." [Tr. p. 280.]

On cross-examination W. W. Wilson testifies:

"Q. Please tell us again when it was that this man Houriet made that discovery.

A. It was very shortly after the underreamer was assembled the first time. That is, I think—I don't believe I saw him assemble that or disassemble it the first time or so. It was only two or three or four days, or something like that, after the underreamer was completed, or ready to assemble the first time, that we were called out to that conference. That is the first I knew about it.

Q. According to your present recollection, when would that have made the date of such occurrence? A. The early part of March, 1911." [Tr. p. 295.]

It is to be remembered that Mr. Houriet testified [Tr. p. 475] that he had been trying to get the key in and out and he had tried prying it out but had found that he *"couldn't get it out that way"* and then he accidentally drove a cape chisel in and saw it raise the key up and that he could drive it right out. "I worked at it two or three hours trying to get it out,

and possibly longer than that." [Tr. p. 484.] He couldn't say on how many different days he had tried to get the key out by prying it. [Tr. p. 484.] Reading, however, the testimony of Mr. Houriet when recalled and questioned by the court [Tr. pp. 691 to 693], Mr. Houriet asserts that he should judge he put in and took out the key two or three times by means of the cape chisel before he called Mr. Knapp's attention to it, and leaves, as the result of his testimony in response to the court's questions, the impression at least that he never succeeded in removing the key in any other manner. Yet E. C. Wilson has testified that the key was removed *by means of a lever for two or three weeks before Mr. Houriet made this discovery.*

It is therefore apparent that the testimony of W. W. Wilson in regard to this occurrence is not to be relied upon. Is it not significant that no one of the other witnesses mentioned W. W. Wilson as having any knowledge of this alleged discovery? In this connection it is to be borne in mind that when giving his deposition in 1914 in the interference in the Patent Office W. W. Wilson says that this reamer #120 "*was probably first assembled in the early part of March,* from my inspection of the time cards, but I am not able to definitely settle this point." [Tr. p. 292.] This testimony again shows that W. W. Wilson, like the other workmen in the shop, has no definite recollection of any of these facts other than as they are shown by the shop records, and that he is testifying from deduction and not from memory when he departs from the shop records.

To say the least W. W. Wilson's testimony in regard to this alleged Houriet discovery is a most remarkable piece of testimony to be considered as corroboration. Complainants submit that on the contrary it is illustrative of the contradictory and conflicting character of the evidence on behalf of the defendants. It is passing strange that if W. W. Wilson was a party to the explanation of this discovery by Mr. Houriet to Mr. E. C. Wilson, that neither Mr. E. C. Wilson nor Mr. Knapp nor Mr. Houriet remembered W. W. Wilson as having anything to do with the matter or as having been present. It is to be considered in this connection that when the trial court recalled Mr. E. C. Wilson and questioned him in regard to this occurrence and gave him several opportunities to state who was present when he, E. C. Wilson, was shown by Mr. Houriet how to remove this key in the manner referred to, Mr. E. C. Wilson fails utterly to name any one except Mr. Houriet who was present, yet it is to be remembered that this testimony was taken in open court; that Mr. E. C. Wilson had heard this testimony given by his brother, W. W. Wilson, and that he knew the purpose of the court was to compare the testimony on this point. Mr. E. C. Wilson knew the court had just questioned Mr. Houriet and Mr. Bole before calling him. It is significant that, in response to the questions asked by the court, he would not on oath assert that his brother, W. W. Wilson, was present. These things and the manner in which they occurred all doubtless had their effect upon the conclusion reached by the court, and it is absolutely impossible to

reproduce for the benefit of this appellate court on this appeal the situation of the witnesses and the attendant circumstances of the giving of their testimony so that this court will be in as good a position to judge the credibility of the witnesses as was the trial court.

So far we have been considering solely the conflicting testimony of defendants' own witnesses and various impeachment of such several witnesses not only by each other but by the conflicting statements made by them in the trial of this case and in their Patent Office depositions. No attempt has been made by complainants to exhaust these conflicts, but only sufficient thereof are brought forward to illustrate the doubtful and conflicting character of the testimony. The direct conflict of testimony does not stop with the defendants' witnesses. Their testimony is in direct conflict with that of the witnesses produced by complainants. A striking example is in regard to who first removed the key with the tang end of a file. We have just analyzed the Houriet story. Let us consider the conflict of testimony on this point. Mr. Bole testifies:

> "I remember it was the morning when the first key was fitted. Mr. Houriet was fitting up the key and attempting to put the key in the reamer while I was fixing a tool to get it out. And I went over —there was a couple of horses or trestles there and this reamer was laying crosswise on it—flat. And Mr. Houriet had a light hammer and had the key and was attempting to drive it in. And I said, 'Let me do that, Al.' And I took the hammer and I couldn't drive it in. The taper was so abrupt and the spring had so much tension on it that

every time you would hit it would fly out. And I said 'We will hit it with a sledge-hammer,' and I hit it with a sledge-hammer and the first crack brought it over this hump and it went in place. After this time Mr. Wilson came along; he had not been there that morning.

Q. You mean Mr. E. C. Wilson?

A. I mean Mr. E. C. Wilson. When he came up he looked at it, and I said, 'Well, it is in place.' He said, 'Yes; you have got it in. Now, let me see you take it out.' And I had ground up this tool—I have ground it up this morning, something similar to it. I ground up a tool like that which was made out of a file. I broke half of the file off and ground this end, and by driving that under this point it raised that up to a position where this was.

The Court: You have it wrong side up.

A. No. The reamer was lying on the side. By driving it in this position it raised this point up until it came out of the bore of the reamer, and then by turning the reamer over and hitting it on the opposite side, we could drive the key out.

Q. (By Mr. Lyon): And I understand you, at that time the reamer was lying on its side?

A. Yes, sir; lying on its side, on a couple of trestles.

Q. Was there anyone else present besides Mr. E. C. Wilson at that time? A. Yes, there was—

The Court: Besides who?

Mr. Lyon: Mr. E. C. Wilson.

A. Mr. Houriet was there and I believe Mr. Wilcox was there. I am quite positive Mr. Wilcox was there, and Mr. Naphas, my pump foreman.

Q. You heard the testimony of Mr. Houriet

that after this reamer 120 was completed he discovered, after some experimentation, that he could remove this single-piece key therefrom by driving a cape chisel under such key. Do you know anything about any such discovery by Mr. Houriet?

A. No, sir. If he did anything like that he did it after I had taken this key out in the first place, and I don't believe it could be done with a cape chisel, anyway, without chipping the bottom of this business here. This would have to be ground. And that is the first key they say they made, and it doesn't show any marks of chipping.

Q. Now, you have seen this diagram of the key which has been drawn at the bottom of 'Defendants' Exhibit Wilson Reamer Key and Tee Sketch of 1911.' Did you ever see a key like that in any Wilson underreamer?

A. I never saw a key like that. The first key did not have these notches in the bottom." [Tr. p. 512.]

When recalled by the court, in answer to the questions of the court Mr. Bole testifies as follows:

"The Court: Who was present when you first used a file to get this key out of the reamer 120?

A. Mr. Wilcox, I believe, was present; he was around there; there was quite a few men around the shop backwards and forwards; they were all more or less interested in it, and Mr. Naphas was there.

Q. Well, to whom did you first call attention to the fact that you could get it out with a file?

A. Mr. Houriet.

Q. Mr. Houriet?

A. Mr. Houriet was right there. As I say,

he attempted to drive the key in; that was the first time it was attempted to put a single-piece key in the reamer, and he was driving it in when I had gone to grind up this file to get it out, and the light hammer he had in his hand would not put the key in; the tension of the spring would cause it to rebound, to come out, it wouldn't go under the spring, and we used a sledge, and Mr. Houriet was there when we did that; I drove the key in with the sledge; I had tried it or he had tried it with a light hammer in the first place, and then I took the light hammer and I couldn't put it in, and then we took the sledge and the sledge drove it in, and that was on account of the steep taper, and then he was right there after it got through and I took this file that I had ground out and took the key out.

Q. Had you removed this key with any other instrument but a file prior to that time? A. No, sir.

Q. Had you attempted to pry it out with one of these things with a hook on the end of it?

A. No, sir; when the key was finished and ready to be pried out the first thing I did was to take one of these old files that was used around for filing up plungers; I broke it in two and took the temper out of the end so that when you hit it with the hammer the steel wouldn't fly; I held it under the wheel until it got cherry red, got a temper on it, and then I took and ground the other end like this tool I had yesterday, and that was the tool I used and that was the first tool used.

Q. When was that?

A. That was about the middle of February, 1913, as near as I can remember.

Q. 1911, you mean?

A. 1911; I am not positive, exactly.

Q. Well, the first time you called Mr. Wilson's attention to it you say Mr. Naphas was present?

A. Yes, sir, that was—Mr. Wilson had not come down from his house yet that morning; he wasn't there when we tried—when we put the key in. Just as we got the key in and I had driven it out—I am pretty sure I had driven it out once or taken it out once, and we put it back and Mr. Wilson came along, and Mr. Wilson said in sort of a sarcastic manner, 'Well,' he says, 'you have got it in; now let's see you get it out.'

Q. And you say Naphas was there?

A. Naphas was there.

Q. At that time? A. At that time.

Q. Now, when was this?

A. This was about the middle of February, 1911.

Q. Well, that was the first time you had ever taken it out with a file?

A. Yes, sir; the first time it was ever taken out at all.

Q. Was Mr. Houriet there?

A. Yes, sir.

Q. Did the key have those offsets in the lower end of it, each end, those little nicks in it as indicated in the drawing here?

A. Heavy brown paper drawing?

Q. Yes, sir.

A. No, sir, it didn't.

Q. Didn't have those in it?

A. Didn't have those in it. The corner was broken or tapered, but it didn't have these notches in it.

Q. Those notches were not in the key that you took out?

A. No, sir, I know they were not; if they were ever in that key they were put in there afterwards.

Q. Now, as I understand, Mr. Naphas didn't testify in this interference proceeding?

A. No, sir.

Q. Why didn't you have him testify in these proceedings?

A. Well, Mr. Lyon said that it was not necessary. I asked him if he wanted me to go and get Mr. Naphas and he said it was not necessary; he said we had the case won; he said there was not anything to do as he could see, and he said we didn't need him." [Tr. pp. 694-697.]

Harry Naphas, called on behalf of complainants, testifies he was foreman of the pump department at the defendants' shop, that the first he saw of such single-piece key device for underreamers was some time in February, 1911. He says:

"Q. (By Mr. Lyon): When did you see the first of such single-piece key devices?

A. Some time in February, 1911.

Q. Where? A. At Wilson & Willard's.

Q. Under what circumstances?

A. Well, the circumstances, the first I seen was they were having a dispute on the key and I at that time was foreman of the Bole Pump Company and went over to ask Mr. Bole something about some pumps we were building, and Mr. Bole was standing there and Mr. Wilson came down the shop, and they were trying to get the key out—Mr. Bole was—I wasn't—and Mr. Wilson says, 'You have got it in; now let us see you get it out.'

Q. Give us the rest of the conversation and state what was done at that time.

A. Mr. Bole took an old file, something similar to this, which I used to file my plungers with, and drove it in and started to wedge it, and it started to come, and I walked away. And that is all I—

Q. Who was the Mr. Wilson that you say was there at that time?

A. Mr. Wilson sitting right there.

Q. You mean E. C. Wilson?

A. E. C. Wilson, not Web. [Tr. p. 693.]

Q. When was it you saw Mr. Bole attempt to put the end of a file under this single-piece key in a reamer? A. In the morning—one morning.

Q. What morning was it?

A. It was on a morning about the middle of February, or maybe a little later, of 1911.

Q. How much later than the 15th of February?

A. I couldn't say exactly as to the day.

Q. Had you ever seen that key in that reamer before? A. No, sir.

Q. Do you know who put that key in the reamer?

A. No, sir.

Q. You didn't see the end of the file go in under the key, did you? A. Yes, sir.

Q. What happened to the key then?

A. The key started to wedge itself out.

Q. Did it move out as well as lift up?

A. Yes, sir; it gradually lifted up, and then I seen Mr. Bole take a hammer and then hit it, and then it started to move out and up at the same time.

Q. It moved up and out when he hit it. And you didn't go away before he hit it?

A. Yes, sir; after he hit it I walked away.

Q. You didn't see the key come out?

A. No, sir. [Tr. 615.]

Q. And you are sure Mr. Wilson was there?

A. Yes, sir.

Q. Nothing was said?

A. No, sir. Mr. Wilson came up and said, 'You have got it in; now how are you going to get it out?' or words to that effect.

Q. And you didn't know whether Mr. Houriet or anybody else around the shop had driven a file or chisel in there before, do you?

A. No, sir. [Tr. 616.]

Q. (By the Court): Was the file that was driven in there changed in any way, or was it a natural file? A. It was a file just similar to this one.

Q. It had been changed a little bit?

A. Well, it had been changed. It was an old, broken file.

Q. Well, had the end of it been changed?

A. Yes, sir.

Q. How?

A. Just simply similar to this here, so he could start it underneath the key. Otherwise, you couldn't get the file in there if it was blunt. So it was sharpened on the end.

Q. Since that date to whom have you told what you saw there? A. From now?

Q. From the time you saw and heard what occurred there about getting that key out, up until yesterday, did you tell anybody about it?

A. No, sir; I haven't seen nobody. I haven't

seen one of the boys at the shop that I worked with or anybody to speak anything about it. In fact, I didn't know anything about it.

Q. Now, who all were there at the time this occurred?

A. Mr. Bole and I were there, and Mr. Wilson came down in the shop in the morning, and Mr. Bole had the key in there and I went up and Mr. Wilson came down and said, 'Now, how are you going to get it out?'

Q. Nobody else there present?

A. No, sir. He was standing looking at it with the key in there.

Q. This is the first time you ever testified about it?

A. Yes, sir.

Q. You never gave any evidence before about it to anybody?

A. No, sir." [Tr. 619-620.]

As thus seen there is the very sharpest conflict between the testimony of Mr. E. C. Wilson and Mr. Houriet, on one side, and Mr. Bole and Mr. Naphas on the other as to this first use of the tang end of a file to remove the key. Who told the truth? It is apparent that the trial court believed Mr. Bole and Mr. Naphas. The trial judge questioned each of the witnesses on this point. He heard their testimony. Can this court say that as a matter of law the trial judge was unquestionably in error as to which story is the truth?

The fact that Mr. E. C. Wilson is forced by the production of the Kibele letter of February 28, 1911, to change his testimony and place the time of Mr.

Houriet's alleged accidental discovery prior to the date of that letter instead of "two or three weeks" after they had been using a lever to pry the key out, is a strong reason why the Houriet story should not be believed. If the Houriet story is not believed, defendants' case utterly falls, as the credibility of the testimony of Mr. E. C. Wilson is totally gone, and it is upon his testimony, alone and uncorroborated, that defendants rely to show that E. C. Wilson conceived the invention and explained it to Mr. Bole. Defendants have only Mr. Wilson's testimony that the sketch shown at the conference of February 3, 1911, was made by E. C. Wilson. And yet upon such a record defendants ask this court to reverse the findings of fact of the trial court.

Mr. A. G. Willard was the owner of half of the stock of the defendant corporation at the time of remodeling reamer 120. At the time of giving his testimony E. C. Wilson was indebted to him in a considerable sum for the purchase of his stock in the defendant company. They had been the closest of business associates for years. He is produced as a witness on behalf of defendants, who thus vouch for him. We may rightly expect that his testimony would be colored in favor of defendants and of his own interest to protect his debtor. He testifies that he first saw "a drawing or sketch of this Wilson reamer one-piece key" in January or February, 1911, but says he does not know who made it or produced it or by whom it was shown to him. [Tr. p. 456.] He testifies that he does not remember who first mentioned such single-

piece key to him. [Tr. 301.] It is significant that defendants do not examine Mr. Willard as to the alleged February 3, 1911, conference. He was in a position to have known. Defendants produce him as a witness, but carefully refrain from questioning him in regard to such alleged conference. Possibly this was in order to keep complainants from cross-examining him before the court as to such alleged facts. His deposition in the Patent Office Interference is not testimony in this case. It was used and can only be used for the purpose of showing the differences in his testimony then and now and now as testimony in chief to support defendants' main case, in lieu of a direct examination. This was the ruling of the trial court in sustaining defendants' objection to complainants' attempted cross-examination [Tr. 303.]

Mr. Willard was a competent and necessary witness for defendants to have produced. The presumption, if they had failed to produce him, would have been that he would not have corroborated the testimony of E. C. Wilson. Should not the fact that defendants produced him on the stand and then carefully refrained from examining him as to the material parts of Mr. E. C. Wilson's story and objected to complainants interrogating him, and securing the ruling that such questions by complainants would not be cross-examination, raise even a stronger presumption against the truth of defendants' case? The burden of proof was on the defendants, and the truth from Mr. Willard would have thrown light upon the controversy. He was in a position to have known whether Mr. E. C. Wilson was

telling the truth. Defendants vouched for him. Why were they afraid to examine him?

The conflict in the testimony does not stop with the particular instances to which we have heretofore called attention. With the exception of the Houriet story and the testimony on behalf of complainants conflicting and contradicting it, we have considered only instances of conflict between the testimony of the defendants' own witnesses. Complainants introduced testimony which is totally at variance with and contradicts and impeaches the whole of Mr. E. C. Wilson's story that he was the originator of this invention or that he explained the same as his invention to either Mr. Bole or any one else. The trial court heard the testimony of all these witnesses and saw their demeanor on the stand and questioned them and found that Mr. Bole was the inventor and entitled to the patent. It is clear, therefore, that the trial judge was satisfied with the truth of complainants' evidence. It is conclusively shown by such evidence that in September, 1908, the defendants were manufacturing and selling the "Wilson" underreamer almost identically as shown in the drawings of the Wilson patent, "Complainants' Exhibit B." [Tr. pp. 739, 740.] The only difference between the showing of these drawings and such reamer as then manufactured being that in place of using "dowel-pins," indicated at 8 in the drawings, defendants had substituted machine screws. Defendants still used the block 7 which was insertible into the bore of the body of the reamer to form a shoulder or seat for the coiled spring 6, thereby forming the sus-

pending means or means for mounting and holding the spring, spring-actuated rod and bits or cutters in the reamer.

About the middle of September, 1908, Mr. Bole received an offer through Mr. Roy L. Heber, the general foreman of the Sunset Monarch Oil Company, as foreman of the machine shop of that company at Maricopa, California. Mr. Bole left Los Angeles to take that position, at least temporarily, until Mr. Heber could secure a satisfactory man. When Mr. Bole arrived, on either September 17th or 18th, he found that Mr. Segur, the vice-president of the company, had arrived from San Francisco the same day with another man by the name of Converse to fill the position as foreman of the shop. As Mr. Bole did not wish to "cause any friction between the general foreman and the manager," he asked Mr. Heber to give him an order for some tools and pay his expenses and to give his brother-in-law a position with the company and call it square on that basis. He secured the position for his brother-in-law, his expenses, and an order for a 9⅝-inch reamer, two sets of reamer cutters and an order for a 10-inch Bole spear. Mr. Heber was not desirous of ordering a Wilson reamer. He stated that they had had so much trouble with the Wilson reamer that they did not want to use it any more. In order to overcome these objections Mr. Bole explained the invention in issue in this suit to him. Mr. Bole says:

> "I showed him how I could make this key and put it in this reamer, and explained to him how it would overcome this difficulty he had had of his

pins freezing and having had to drill them out. And he gave me an order on the strength of my recommendation.

I drew out on a piece of paper a sketch of this key to show him; showed him how it could be put into the reamer, how it could be taken out; showed him all about it as I had desired to make it, had wanted to make it.

Well, I told him that by putting this slot in and leaving space enough to get the key in it could be driven right in from the side of the reamer and when they got it in there the projection at the bottom would snap down into the bore of the reamer, and the tension of the spring would hold it in place, and it could be taken out by simply driving a drift at one end and prying it up at the lower edge of the opening and it could be driven out from the opposite side.

Q. When you say 'driving a drift,' what do you mean by 'drift'?

A. A drift or punch; anything pointed that would fit in under there." [Tr. pp. 491, 492.]

Mr. Bole made out the order for this reamer, the extra cutters and the spear and mailed it to Mr. A. G. Willard, Mr. E. C. Wilson's partner, in the Wilson & Willard Manufacturing Company, at Los Angeles. This order was in letter form and is thus explained by Mr. Bole.

"I wrote this letter to Mr. Willard, and, as I went along in the letter, I made little descriptions or drawings, as was a custom of mine. I didn't send any drawing of it—any separate drawing accompanying it. The description was not among the written matter. As I went along in the letter

> I described how I wanted this made, and I told him to start to work on the body of the reamer, and they wanted it to be shipped up immediately, as soon as it was completed, and that when I got back to Los Angeles, as the key was the last thing fitted to a reamer, that we could finish up the job and put this key in and send it up there, and I would explain to him more fully how I wanted it, but to start in and make the reamer body itself." [Tr. p. 493.]

Mr. Bole made and there was offered in evidence as "Complainants' Exhibit F" [Tr. pp. 509-10] a reproduction of the drawings and sketches which accompanied this order from Mr. Bole in September, 1908, to the defendants. This sketch or drawing is reproduced on page 751 of the transcript.

A postal card, "Complainants' Exhibit D" [Tr. 746], is produced and offered in evidence, showing that on September 19, 1908, Mr. Bole was at Coalinga, California, having left Maricopa. This postal card agrees with the time sheets of the Wilson & Willard Manufacturing Company, which show that Bole was absent from the shop of that company from September 12th to and including September 20th, 1908.

Mr. Heber fully corroborates Mr. Bole in regard to Mr. Bole having come up about the middle of September, 1908, to take charge of Sunset-Monarch shop, and in regard to the conversation with reference to the objections which the Sunset-Monarch had with the Wilson reamer, the explanation of this invention to Mr. Heber by Mr. Bole at that time, September 16th,

17th or 18th, 1908, and the order then given. Mr. Heber testifies as follows:

> "I complained about the Wilson underreamer giving trouble with the pins. The pins had to be drilled out, which was bothersome. That was the block and screw type. I talked that over with Mr. Bole and he said he could improve it if I would give him an order; that he would guarantee to send an underreamer that would not give trouble, and I gave him an order for the underreamer and for a 10-inch casing spear. We sat down in the shop and I asked Mr. Bole what kind of an improvement he had in mind which would avoid the troubles we had had with the pins which held the block in place, and he sketched a key while sitting in the shop, and said that that would give satisfaction and that we would not have any trouble with the underreamer fitted with this key. The key was an ordinary gib-key and the underreamer was to be provided with a slotted mandrel or tee bar, the body of the underreamer having a slot through which the key could be pushed into place to seat in the central bore of the underreamer, and the tee bar or mandrel could work up and down on this key by reason of the slot in the tee bar. The spring which surrounded the mandrel or tee bar would bear on the top of the key. The wing or projection of the key sticking down into the bore of the underreamer so that the shoulders at each end of the wing would hold the key from sliding out. The tension spring bearing on the top of the key would hold the key in place, the upper end of the spring bearing against a nut on the end of the slotted tee or mandrel. This key, Mr. Bole said, could be readily removed by simply

prying up one end and driving the key out. Mr. Bole made a sketch of the key at that time when he was giving me this explanation. My recollection is that that sketch was made on a piece of paper with a lead pencil.

Q. 26. Do you know what became of this sketch?

A. I do not. I don't think it was kept.

Q. 27. Could you reproduce for us such sketch?

A. I don't know whether I can give an exact drawing of it, but I will give you the way it appears to me now. This is the way it looks to me. (Makes a sketch.)

Mr. Lyon: The sketch just made by the witness is offered in evidence and marked 'Bole's Exhibit Heber Sketch.'" [Tr. pp. 716, 717.]

The deposition of Mr. Heber further shows that there was friction between Mr. Heber and Mr. Converse, Mr. Converse not being a practical oil company machinist, and that when Mr. Converse took charge of the shop he, Heber, paid no particular attention to that part of the work thereafter and therefore paid no particular attention to the filling of this order so given to Mr. Bole. Mr. Heber left the company soon after.

Mr. Bole testifies that not only did he explain this invention to Mr. Heber, as aforesaid, but that he explained it to a machinist, Gus Adams, who was employed in the Sunset-Monarch shops at the time. Mr. Adams was familiar with both the "block-and-screw" and the "two-piece-key" types of Wilson's reamer, and all that was required from Mr. Bole to Mr. Adams in explanation of this invention so that Mr. Adams would

understand it was a sketch or drawing of the shape of the key and the statement that it would be put into the slot in the reamer body in place of the old two-piece key. Mr. Adams being thoroughly familiar with the Wilson reamers and being a machinist readily understood this description of this invention.

Mr. Adams was called as a witness on behalf of the complainants and fully corroborated Mr. Bole as to this explanation of the invention. [Tr. pp. 623 to 628.]

On cross-examination Mr. Adams testifies as follows:

> "Q. You don't remember anything said at the time you made this sketch in chalk up there in Maricopa in 1908?
>
> A. He said the reason he was getting the order for the underreamer from Mr. Heber was owing to the fact he was putting a different key in it; and that is how he come to show me the key—the sketch of the key, rather.
>
> Q. Did he show you anything beside the outline of the key? A. He did not, at the time.
>
> Q. Did he state how the key was to be used?
>
> A. He told me he put it in the slot instead of the two-piece key and let the gib hold it in place.
>
> Q. Did he tell you how he proposed to get the key out?
>
> A. I think he told me he could drive a wedge under one end of it and lift it out.
>
> Q. And lift it out with the wedge? A. Yes.
>
> Q. Pry it out with the wedge? A. Yes.
>
> Q. Drive a drift under it and pry it out with a wedge? [Tr. p. 631.]

Q. Did you make any inquiry why that order was not filled?

A. Why, he told me that Mr. Wilson would not make the reamer with that key in it, for some unknown reason.

Q. When did he tell you that?

A. That was the first time I saw him afterwards, in the fall." [Tr. p. 632.]

Mr. Bole's testimony is further corroborated as to the mailing in to defendants this order for this modified reamer embodying the invention in issue. Mr. Willard, Mr. E. C. Wilson's then partner, was called as a witness to rebut the testimony of Mr. Bole. He testifies that this order was received through the mail at the shop of the Wilson & Willard Manufacturing Company; that it called for a 9⅝-inch Wilson underreamer, "and in this letter or order that I received there was some mention of some change." Defendants' counsel asked him a direct and leading question:

"Q. Did that change relate to a single-piece key for the Wilson reamer?

A. It has always been my impression that that change referred to the holding means." [Tr. p. 651.]

On cross-examination Mr. Willard gives the following testimony:

"Q. You used the term here this afternoon that it was your recollection that in this order for the Sunset-Monarch reamer, sent down by Mr. Bole in September, 1908, there was either a sketch or some description of some change to be made in the

holding means. What do you mean by 'holding means' in that answer?

The Court: I didn't understand that myself.

A. I mean by the words 'holding means' the means that help to confine the spring within the body of the reamer.

Q. (By Mr. Lyon): And hold up the—

A. Tee bar.

Q. The spring actuation—

A. Hold up the tee bar." [Tr. p. 656.]

Mr. Willard was called as a witness by the defendants. From all association with him they knew him well; they vouch for him by calling him as a witness.

A reading of the depositions given by Mr. Willard in the Patent Office Interference shows conclusively that he has made every attempt possible on his part to assist the defendants, even hiding behind the stereotype answer "I don't remember" as to most material facts. His Patent Office depositions, however, show that he testified that this order so sent down by Mr. Bole did contain some kind of a sketch of a key device for the underreamer as ordered and was for a Wilson underreamer with the slotted tee bar. [Tr. p. 364.]

It is remarkable that with the elaborate and careful system of keeping records in vogue in the shop of the defendants that this order cannot be found, and it is to be explained only on one hypothesis, and that is that the order with the suggestion of the changes was sent to Mr. E. C. Wilson at Bakersfield or given to him about October 1st, 1908, when he was in Los Angeles at the shop of the defendant corporation and assisting

his brother in the acquisition of a thorough knowledge of the records, the keeping of the records and how to keep the books of said corporation. Mr. Bole testifies that on numerous occasions between September, 1908, and February, 1911, Mr. E. C. Wilson discussed this proposed change with him.

This proof that Mr. Bole originated or conceived this invention as early as 1908 has a double aspect in this case. It has already been pointed out that there is no testimony or evidence of any kind to corroborate Mr. E. C. Wilson's claim or testimony that he originated this invention or that he made the sketch which he claims to have shown to Mr. Bole, Mr. Willard, Mr. W. W. Wilson, Mr. C. E. Wilcox and perhaps Mr. Knapp at this alleged conference which he claims to have called on February 3, 1911. Not a scintilla of record or documentary evidence is produced on behalf of the defendants to support E. C. Wilson's uncorroborated testimony. On the other hand that such explanation and such sketch may have emanated from Mr. Bole and an explanation by Mr. Bole to Mr. Wilson is clear from the testimony of Mr. C. E. Wilcox.

In judging the probabilities of this the court must necessarily, and the trial court evidently did, take into consideration this conclusive proof by the testimony of Mr. Bole, Mr. Heber and Mr. Adams that Mr. Bole had discovered or conceived this invention years before and was in full possession of it prior to this alleged conference. If the court accepted this testimony of Mr. Bole, Mr. Heber and Mr. Adams, corroborated by the testimony of Mr. Willard as before stated, then it is

easy to see why the impeached and contradicted and contradictory testimony of Mr. E. C. Wilson was not believed and why the trial court would not accept Mr. E. C. Wilson's uncorroborated testimony.

The fact that Mr. Bole well knew of this invention long prior to this alleged conference of January 3rd, 1911, is established by the testimony of Mr. Heber and Mr. Adams. On the other hand, there is only Mr. E. C. Wilson's own testimony that he went into this conference with any idea of the invention as originated by him, although we have Mr. Bole's testimony that long prior to this date he, Bole, had explained this invention to E. C. Wilson. The proven situation of the parties, E. C. Wilson and Bole, and the established fact that Bole had full knowledge of the invention prior to 1911 must be an extreme factor in arriving at a finding as to the true situation of the parties at such alleged conference. The utter contradiction and impeachment of E. C. Wilson's testimony and the utter unreliability of it is thus clear.

We have heretofore pointed out the fact that although E. C. Wilson testifies he gave his original sketch to Mr. Knapp, the foreman, as a part of shop order 6904 for the remodeling of reamer 120 Mr. Knapp denies this.

Mr. Bole is asked [Tr. 499] whether he knows anything about how it happened that the defendants took up the manufacture of a reamer, or the making over of a reamer, embodying this single-piece key invention, and in answer testifies:

"Mr. Wilson had been having considerable trouble with the reamer he was using, at that time—that is, 'up to that time,' I mean about the 1st of January, up to the 1st of January, 1911. The sales had been falling off in different fields, and he was having considerable trouble with the reamers. That is, the reamer block and screw type he was using. And he said to me one day there, he says, 'I don't understand why it is that they have so much trouble with this reamer.' I said to him, 'Why don't you make that reamer that I designed for the Sunset-Monarch Oil Company, the one that was ordered by the Sunset-Monarch Oil Company?' He says, 'It seems to me Mr. Willard and I had some correspondence about that, didn't we?' I said, 'You certainly did.' He said, 'What was that like?' And I had to explain it to him again. He had forgotten all about those conversations, I suppose. At any rate, he asked me to explain it to him again. And I got down on the floor and with a piece of chalk showed him how I could make this one-piece key and put it in the reamer and take it out. And he said, 'The trouble with that tee bar is it is weakly constructed,' and I said, 'You can strengthen that by increasing the size of it and flattening out the spring to accommodate it.' At that time they were using the round springs; the material they were made of was round material. By flattening it out he could get more space to put in a heavier tee bar." [Tr. p. 500.]

"He said that he didn't believe it could be taken out. And I argued with him, and this matter was taken up on several different occasions. I took it up with him and tried to convince him, and he said it would have to be pried out; and I

> told him, at the time, a drift could be driven in under the key, and it be raised on one side and the key driven out from the other side. It was a simple proposition on the face of it, to my notion. There is hardly any other way to take it out." [Tr. p. 502.]

Asked whether he knows anything at all in regard to a single-piece key device having been built and made and installed in any underreamer at that time, Mr. Bole testifies that he does and says:

> "This key was made up under my instructions. I made out a sketch which was attached to the original shop order. I think that went through the pump department; at any rate, the key was built under my instructions. I did some work on it myself in filing and fitting, and I remember distinctly driving the key in place the first time it was put in the reamer. The key at that time, it was uncertain what taper to put on it to drive under the spring. I remember distinctly that this drawing of mine had on this taper 'See Bob for the taper,' with my name on it at that time." [Tr. p. 511.]

The defendants were the keepers of all of the original records in regard to these transactions and it is most clearly proven that they had a most elaborate system of keeping all such sketches including all the original sketches and drawings. It is significant in this case that although the foreman, Mr. Knapp, denies that he received any sketch whatever from Mr. Wilson of this single-piece key and does not testify that he, Mr. Knapp, made any such sketch. The workman,

Fritz Rydgren, who made the first single-piece key, testifies that he made the single-piece key *from a sketch and that it was necessary for him to have such sketch to make it from.* Mr. Rydgren testifies:

> "There was no reamer key made by me until I got the sketch from some one, I don't know who gave me the sketch, but there was a rough pencil sketch on a piece of wrapping paper handed to me." [Tr. p. 688.]
>
> "Q. (By Mr. Blakeslee): From whom did you obtain such sketch?
>
> A. I don't remember who gave me the sketch." [Tr. p. 689.]
>
> "Now, in making up those keys and forging them, you had to have some directions in the beginning as to the size of the key and the wing on it, and so forth, didn't you? A. Yes." [Tr. p. 690.]
>
> "Q. And that was the purpose of this sketch? A. That was the purpose of the sketch." [Tr. p. 691.]

Mr. Bole's testimony that this first single-piece key was made up under his instructions and that he made out a sketch which was attached to the original shop order finds further corroboration in the testimony of complainants' witness, Harry Naphas. Mr. Naphas was asked if he ever saw the one-piece key itself before he saw Mr. Bole prying it out with the end of a file in the presence of Mr. E. C. Wilson. He stated:

> "The first I seen that was when Mr. Wills handed it over to Robert E. Bole at his desk.
>
> Q. What did Mr. Wills do with this single-piece key at that time?

A. He gave it to Mr. Bole. That is, he didn't give it to him; he laid it on my desk like that, and he simply picked it up." [Tr. p. 614.]

Mr. Bole, after testifying that this first single-piece key was made under his instructions, testifies [Tr. p. 514] that the first single-piece key made did not have the notches in the bottom like the tracing of the key on Defendants' "Exhibit Wilson Reamer Key and Tee Sketch of 1911." [Reproduced transcript p. 814, such notches being marked with an arrow and T.] Mr. Bole also testifies that this first single-piece key that he had made and that he tried out and with which he showed E. C. Wilson that he was correct as to the feasibility of removing by driving a sharp edge like the tang end of a file under, so far as he knew was not the one that was actually used in the underreamer after the experimental stage had passed. He says he does not believe it was; that the key was "too weak." That the single-piece key that he had made was made of a size to be and was inserted in the slot which had been made for the old two-piece key and such slot was narrower than was required for a single-piece key. [Tr. pp. 514, 515.] Mr. Bole testifies in regard to this first single-piece key as follows:

"Well, it was made to fit the old slot that was in the old reamer, because it was an uncertain quantity. They had not tried it out yet, *and it was only to be made up to be tried out.* The heaviest thickness in that one-piece key would be the same size as the slot that was in the reamer. That slot was made to fit a two-piece key in. In

other words, this key to go into the same space as the two-piece key would be weaker, and this key was afterwards made stronger." [Tr. p. 514.]

This testimony is in accordance with ordinary human experience in the building of new devices. It would be most unusual for the first device to have been perfect or to have been exactly as desired or to have been made with a view to actual commercial use. It also finds corroboration in the fact that shop order 6904 as dictated by Mr. Wilson is totally silent as to any kind of a "holding means" or single-piece key. The very fact that shop order 6904 is silent and makes no mention whatever of such holding means is record and documentary corroboration of Mr. Bole's testimony.

Mr. Bole is enabled to fix the fact definitely that he had conversations with Mr. E. C. Wilson and explained this invention to him prior to the 27th day of January, 1911, by the fact that Mr. Wilson was insisting a single-piece key could not be removed by driving the tang end of a file or the end of a narrow chisel, like a cape chisel, under the key but that on the contrary it would be necessary to pry such key up, and by the fact that on January 27, 1911, he made a sketch of a lever for this purpose of prying the key up and had it witnessed by two men working in the shop. As Mr. Bole explained in his testimony his purpose of making this sketch was simply to produce a means of overcoming Mr. E. C. Wilson's objection that Bole's suggested manner of lifting the key and driving it out was impractical. The sketch that Mr. Bole

made at that time shows the single-piece key. It is important, however, in this case as a memorandum made at the time and by which Mr. Bole is enabled to fix the date. It must have been before this date that this matter was discussed. The sketch is in evidence as "Complainants' Exhibit E" and is reproduced on page 749 of the transcript of record. This is the sketch or drawing referred to by the trial court in announcing its decision in this case. It is apparent that the trial court after hearing of the witnesses was satisfied beyond doubt as to the genuineness of this sketch and that it was made at the time it is dated, to-wit, January 27, 1911, and was witnessed at Mr. Bole's request by both Mr. Fahnestock and Mr. Grigsby. Mr. Fahnestock and Mr. Grigsby were in the employ of the defendant corporation. At the time of the trial in this case Mr. Fahnestock was still in the employ of the defendant corporation. Both of these men were called by the defendants in an attempt to deny the genuineness of this sketch. Both admit the genuineness of their signatures on the sketch and the most that either of them will say in favor of defendants is that they do not remember that they signed the sketch. An example of this is the answer of Mr. Fahnestock on cross-examination [Tr. 675], as follows:

> "Q. Did you attempt at any time to deny that this was your signature on this Complainants' Exhibit "E"?
>
> A. No, I don't know as I have attempted to deny that that was my signature."

Mr. Bole testifies to the making of this sketch and that Mr. Fahnestock and Mr. Grigsby on January 27,

1911, at his request signed it as witnesses. The sketch is admitted to contain the genuine signature of Mr. Fahnestock and Mr. Grigsby. In other words, both of these men admit their signatures. Here is a written document. It contains the admitted signatures of two witnesses. Both of these witnesses admit the signatures are genuine. Is not the burden of proof upon him who would dispute the genuineness of the instrument? Is not the burden of proof upon him to prove any assertion that there had been any change or alteration of the document after the signature of the witnesses? Complainants submit that the production of this written instrument in evidence bearing the genuine signatures of the witnesses at the bottom and the production of the witnesses by the defendants and their admission that their signatures are genuine proves the genuineness of the instrument. It is only upon hypercritical grounds that the sketch can be questioned. Mr. Bole gives us in his testimony a full explanation of its making. Defendants urge that it is passing strange that Mr. Bole should have had a sketch witnessed of simply this key removing device and not a sketch of the key invention itself. It must be remembered that the key invention was produced by Mr. Bole in September, 1908, and a full explanation of it and a full drawing of it sent to the defendant corporation. At that time Mr. Willard, Mr. E. C. Wilson and Mr. Bole were most friendly. On cross-examination Mr. Bole is asked why it was if he thought this key invention was of such importance that he did not perpetuate the idea by some sketch, back in 1908, and Mr. Bole answers:

> "Mr. Blakeslee, I thought that was all a matter of record. It is the custom of the Wilson & Willard Manufacturing Company to file the letters and orders in the envelope with the time cards all the way through, and it is the shop custom when you get anything in an order for any new thing, that it is on record. At least that is the general impression around the shop, that if you get anything on a shop order and in the files, that it is a record, and I didn't believe that anybody would ever lay any claim to that but myself." [Tr. pp. 526-7.]

This controversy was one essentially for a trial in open court with a full opportunity to the trial court to see the witnesses, observe them in their demeanor on the stand and to himself ask questions of the witnesses. There is another subordinate issue of fact which was raised upon the trial and which doubtless had a very material influence upon the trial judge's judgment of the witnesses and their testimony. An attempt was made by the defendants to prove their second defense, i. e., that Mr. Bole as a part of the settlement on February 1, 1913, of the Bole Pump Company's business withdrew and waived all claim or right of the invention in issue as a part of such settlement. It was in connection with this contention that the total unreliability of the memory of W. W. Wilson was so glaringly shown and his entire testimony impeached. He testified that such settlement was not in writing and that there was no written contract of settlement. The written instrument was produced and he was forced to admit that he had signed it as a witness. An attempt

was made at the trial of this case to alter, change, modify and vary the terms of this settlement by showing a contemporaneous oral agreement providing other terms, to-wit, a waiver of this invention or the grant of a license to use this invention by Mr. Bole as a part of such contract. The trial court properly excluded this testimony. No exception was reserved by defendants to this ruling of the court as required by equity rule 46 and no request was made of the court to "take or report so much thereof, or make such a statement respecting it, as will clearly show the character of the evidence," etc. The ruling of the court, in rejecting this evidence is not before this court for review.

It will be found that the court did admit the testimony of E. C. Wilson, W. W. Wilson and R. E. Bole as to the conversation had at the time of this settlement for the purpose of ascertaining whether what was said at that time indicated in any manner who was the originator or inventor of this invention. In this connection it is again important to remember that although A. G. Willard is shown to have been one of the persons present and was called as a witness in this case on behalf of the defendants he was not interrogated as to that conversation. There was sharp conflict and contradiction between the testimony of E. C. Wilson and Robert E. Bole and the testimony of W. W. Wilson and R. E. Bole. The trial court after hearing this testimony apparently believed Mr. Bole.

At the time of this settlement defendants had brought suit against Mr. Bole and had attached all his physical property. On page 776 of the transcript is printed

a copy of Mr. Bole's letter of January 17, 1913, to Mr. E. C. Wilson as president of the defendant corporation. The character of this letter was certainly such as to bring home most forcibly to Mr. Wilson and the defendant corporation the necessity of including in writing every settlement that was made between the parties and should have placed the defendant corporation and Mr. E. C. Wilson on guard at the time of making such settlement with Mr. Bole. We believe that the trial court received the right impression from this Bole letter of January 17, 1911. The trial court says:

> "The letter that Bole wrote to Wilson, when he got into a controversy with him, is, it seems to me, the most natural thing in the world for him to do, in that he makes claim that he will not let Wilson use the invention any longer, or words to that effect. I think it was a very unnatural and unusual thing for Mr. Wilson to do,—if he claimed to be the inventor of that key,—to make a settlement with Bole, without including in that settlement the controversy concerning the key. It was very unbusinesslike and very unnatural."

In this connection it is to be remembered that Mr. Bole testifies that he, Bole, flatly refused to include this invention in that settlement or to give defendants this invention and this testimony on the part of Mr. Bole is born out by his subsequent act in making the application for the patent in suit in less than two weeks after this settlement contract was executed. It is inconceivable that the defendants would have settled and compromised their claim against Mr. Bole and

released the attachments covering all his physical property without the inclusion of this invention in such settlement had they at that time even thought of making a claim that Mr. E. C. Wilson was the inventor. In fact, the testimony of both E. C. Wilson and W. W. Wilson as to this alleged conversation is susceptible of only one conclusion and that is that all of the parties to such conversation considered this invention the invention of Robert E. Bole. None of them say that Mr. Bole said he would admit that Mr. Wilson was the inventor.

Clearly the defendants have not sustained the burden of proving the origination of this invention by E. C. Wilson beyond reasonable doubt. On the contrary the trial court was correct in its judgment that the evidence "thoroughly convinced" without "the slightest doubt" that Mr. Bole was the inventor.

The appellants' 10th assignment of error is that the district court erred in receiving in evidence the deposition of Roy L. Heber. The defendants admitted at the trial that they had received due and sufficient notice of the taking of Mr. Heber's deposition and that the ground given in such notice for taking such deposition was that the "said Roy L. Heber is about to leave the southern district of California and the state of California and probably will not return thereto at any time prior to the 23d day of March, 1915, the date upon which the final hearing for trial of the above entitled suit is set, and this deposition will be taken to preserve the testimony of said witness on behalf of the complainants in said suit."

The objection that was made to the reading of this deposition in evidence was that the deposition was not taken in accordance with rule 47 of the new equity rules inasmuch as this case had been at issue more than ninety days prior to the taking of such deposition.

Mr. Heber's deposition was taken by virtue of and in accordance with section 863 of the revised statutes of the United States and it was shown by the notice given and by the testimony of the witness that Mr. Heber was about to leave the jurisdiction of the trial court and to depart to a place beyond the reach of the subpoena and over one hundred miles to the place where the trial of this suit was to take place so that under section 863 as Mr. Heber was "about to go out of the district in which the case is to be tried, and to a greater distance than one hundred miles from the place of trial," the absolute right to preserve his testimony in deposition form was given to complainants by this section of the statute.

During the running of the time limited by rule 47 for taking depositions, (under commission before an examiner or other officer named by the court), there was no cause or reason for taking the deposition of Mr. Heber. He was at that time, as his evidence shows, residing within the southern district of California and had no then intention of removing therefrom.

Complainants insist that they had the absolute legal right to take Mr. Heber's deposition at the time and in the manner in which it was taken and as it was conceded at the trial that Mr. Heber was still outside of the southern district of California, to-wit, in the

eastern district of Illinois, complainants had a right to read the deposition in evidence.

The right to take the deposition under these circumstances is given by R. S. U. S., section 863, and is an absolute right. It is to be borne in mind in this connection that it is this same statute which gives to the Supreme Court the right to make the rules in equity and that the power thus granted by this statute to make such equity rules is restricted to modes "which are not inconsistent with any law of the United States." If therefore new equity rule 47 could be construed as intended to limit absolutely the right of a party to take a deposition for whatever cause to the time therein set or to the manner therein set such rule would be in controversion of this statute and unconstitutional, void and migatory. But it is not necessary to so hold. New equity rule 54 particularly and specifically recognizes the right to the parties to take depositions as provided by section 863. No attempt is made by equity rule 54 to limit the time. There are several reasons why rule 54 is silent as to the time within which such depositions may be taken and this particular case at bar illustrates most clearly the reason why such rule is so silent as to time. The exigency for the taking of Mr. Heber's deposition did not arise until after the case had been at issue for a longer time than referred to in rule 47. It has always been held that no order of the court was required to put into effect section 863 and that the right of the party to take the deposition of the witness thereunder was an absolute right when any one of the conditions precedent of the statute was pre-

sented as in this case. Mr. Heber was about to go out of the district in which this case had been pending. The taking of his deposition fell directly within the provision of this section of the statute and the statute was self-executory. This has been recognized by the Circuit Court of Appeal of the Second circuit in

In re National Equipment Company, 195 Fed. 488, 489, in which, speaking for the court, Circuit Judge Lacombe says:

> "This rule apparently and the order heretofore made do not apply to testimony which may be taken *de bene esse* under section 863, U. S. revised statutes (U. S. Comp. St. 1901, p. 661), where the witness lives at a greater distance than 100 miles from the place of trial, or is about to go out of the United States, or is ancient or infirm, etc. It would not be within the power of the district court or of any judge to deprive a party of the rights accorded to him by that section. Indeed, the rules of the Supreme Court in reference to the mode of proof in causes of equity must be construed so as not to conflict with the provisions of that section, for the power of that court to prescribe modes of taking evidence in suits of equity is restricted to modes which are 'not inconsistent with any law of the United States.' Sections 862, 917, U. S. Rev. Stat. (U. S. Comp. St. 1901, . ., 661, 684.)

See also

Stegner v. Blake, 36 Fed. 183;

Arnold v. Cheseborough, 35 Fed. 16

As said by Circuit Judge Lacombe, in Henning v. Boyle, 112 Fed. 397:

> "The method of taking testimony by commission is cumbersome and unsatisfactory, and not resorted to when the convenient method of taking proof prescribed by section 863, Rev. S. U. S., is available. That section provides for the case of a witness who lives at a greater distance than 100 miles from the place of trial. *No order or direction of the court is required antecedent to such examination. The right to take it upon notice merely, in the manner prescribed, is given absolutely to the party by act of Congress.* If question is to be raised as to the reasonableness of the notice, or as to the regularity of the proceedings, it may be raised by motion to suppress."

Defendants' objection to the reading in evidence of Mr. Heber's deposition was properly overruled by the court for the further reason that defendants had not proceeded in accordance with the established practice to suppress the deposition. It was too late at the final hearing to object to the deposition or to object to it being read in evidence. If defendants wished to test the right to take this deposition defendants' appropriate action was by a motion to suppress the deposition. Defendants had full notice and knowledge of the taking of the deposition and under equity rule 55 the deposition was published and notice thereby given to defendants thereof on the date upon which it was filed, which was February 13, 1915. At the trial defendants acknowledged actual notice of its publication, Had defendants moved to suppress this deposition the court

in its discretion would have had full power to have ordered that complainants be granted a given time within which to retake the deposition, if it held that the procedure had been erroneous. By such motion to suppress complainants would have been put on notice and then would have had an opportunity to have brought Mr. Heber from Illinois to testify in open court,—if Mr. Heber had been willing to come. It is obvious that neither the court nor complainants nor defendants could have compelled Mr. Heber to have come from Illinois to testify but if such a motion to suppress had been made in time by defendants and had been sustained, complainants would not have been put in the position of being compelled absolutely to go to trial without Mr. Heber's testimony.

It has long been the rule in equity that where depositions were taken and filed out of time but no motion to suppress was made that the depositions would be considered.

See Mathews v. Spangenberg, 19 Fed. 823.

On this subject Mr. Walker, in his treatise on Patents (4th Ed.), section 639, page 495, says:

> "Depositions taken out of proper time will be considered on the hearing, unless there is a prior successful motion to suppress them."

Mr. Robinson, in his work on Patents, vol. 3, sec. 1128, page 472, says:

> "Evidence taken after the appointed time will be considered unless a motion to suppress is presented."

Mr. Street, in his work, Federal Equity Practice, vol. 2, page 1097, says:

"§ 1824. The mere making of an objection to a deposition or part of it is often sufficient to admonish the other party of the existence of the defect pointed out by the exception; and he will thus avail himself of an early opportunity to cure the defect, if he considers it to be material. If, however, he chooses not to do this, it is necessary for the party who wishes to insist upon the objection to make a motion in due course for the suppression of the deposition or the objectionable part of it. If the defect is such as not to have been available as a ground of exception before the filing of the deposition in court, then the motion to suppress can be made at once without any previous objection or exception having been taken. The purpose of the motion to suppress is to get rid of the deposition and thus prevent the party in whose behalf it was taken from reading it at the hearing."

"§ 1825. A motion to suppress a deposition for irregularity should be made as soon as practicable after notice of the defect. Upon filing and publication of testimony, a party is chargeable with knowledge of irregularities apparent in a deposition, and the motion should normally follow immediately thereafter.

"But a motion to suppress or strike a deposition is apparently not too late if made before the taking of testimony has been closed and the cause set for hearing, *because until that time the other party may have the opportunity afforded him of retaking such deposition.* There is no case in which a motion to strike out a deposition made before the cause was set for hearing was denied on the

ground of laches or delay. In every case in which the motion was denied on the ground of delay the cause had been set down for hearing."

"§ 1818. We now come to consider the mode in which and the time at which objections can be taken to informalities, irregularities, or other defects, in the taking of a deposition. The general rule is, first, that the party who wishes to complain of any irregularity must make an objection at the time when the irregularity occurs or as soon thereafter as it is practicable for him to do so; and, secondly, that he must subsequently follow up this objection by a motion to suppress the deposition or so much of it as may be subject to the objection."

The admission by the court of the Heber deposition was therefore correct for two reasons. First: Complainants had the absolute right under section 863 of the Revised Statutes under the exigency arising of Mr. Heber suddenly going out of the Southern District of California to take his deposition *de bene esse*. Second: The deposition having been taken and having been published and defendants having actual knowledge of its taking and publication are in no position to object at the trial, not having made a motion to suppress such deposition.

The 11th assignment of error is based upon an utter fallacy and misconception of the law. The judgment in an "interference" proceeding in the United States Patent Office is not *res adjudicata* even between the parties thereto, and the Wilson & Willard Manufacturing Company was not a party to such interference.

Even if such a judgment were *res adjudicata* between the parties it is not shown that any final judgment has been rendered in such interference. On the contrary, it is positively proven that the decision of the Examiner of Interferences was simply a decision of the first tribunal, and that so far as any effect in this case or any other case is concerned it was set at naught by the appeal which was pending at the time of the trial of this case. If such *decision* (*not judgment*) can be likened in any manner to a decree of a court it is clear that its effect is vacated and set aside by the appeal. It has always been held that until such a decree becomes final it cannot be pleaded as a final judgment or used for that purpose. This rule of law is ably set forth in the opinion of Judge Hanford in Bowers Co. v. New York Co., 77 Fed. 980, 983, as follows:

> "Third. A judgment or decree * * * cannot be regarded as final * * * if the cause in which such judgment or decree has been rendered has been subsequently removed into an appellate court for review, and remained undetermined and pending in the appellate court."

This is the general rule of law, and is based upon sound reason.

There is, however, another, further and even greater obstacle to the adoption of the contention of defendants in this regard. There was nothing before the court to show upon what kind of a record or upon what testimony this primary tribunal of the Patent Office (called the Examiner of Interferences) based his decision. Defendants did not offer in connection with such opin-

ion of the Examiner of Interferences a copy of the entire record to show what was before such tribunal *or to attempt to prove that the record as there made and the record as before the trial court in this case were the same.* On the contrary, it affirmatively appears in this case that additional witnesses were produced on behalf of the parties to this litigation. It affirmatively appears from the cross-examination of the witnesses that there is a material difference in the record. That the decision in such an interference proceeding is not *res adjudicata,* see

R. S. U. S., Sections 4915 and 4918;
Walker on Patents, Section 142;
Morgan v. Daniels, 153 U. S. 153;
Standard Cartridge Co. v. Peters Cartridge Co., 77 Fed. 630;
Thomas & Sons Co. v. Electric Co., 111 Fed. 929.

The reason for this rule is apparent. When the government of the United States, acting through the United States Patent Office and the Commissioner of Patents, granted, issued and delivered to complainants the patent in suit, the Patent Office lost entirely its jurisdiction over such patent. There is no provision of the statutes which gives the Commissioner of Patents any jurisdiction, authority or power to cancel or annul a patent once issued. That authority is vested in the District Court of the United States under Section 4918 of the Revised Statutes. Walker on Patents, Section 315. The sole object and purpose of the inter-

ference proceeding pending between the application of defendant, Elihu C. Wilson, and complainant, Robert E. Bole, in the United States Patent Office, is to presumptively determine whether a patent shall be issued to Mr. Wilson, and the decision of the Patent Office is not final. If the final position in such interference is against Mr. Wilson, he may, under R. S. U. S., Section 4915, by a bill in equity, litigate such refusal, and in such case he is required to make complainants and the Commissioner of Patents defendant. Such suit would be brought in the District Court of the United States before the district in which the rival inventor and his assignee reside and inhabit. In this particular case it would be in the Southern District of California, at Los Angeles.

In case the determination of the so-called interference proceedings in the Patent Office were in favor of Mr. Wilson, and a subsequent or junior patent should then be issued to him, it would still be necessary for him to bring suit in the District Court of the United States for the Southern District of California against these complainants to set aside the prior Bole patent herein sued on as an "Interfering Patent" under Section 4918, before he, Mr. Wilson, could enforce the junior patent granted to him. Likewise, if such interference proceeding in the United States Patent Office terminated in favor of Mr. Wilson, complainants could bring a suit under said Section 4918 to set aside the Wilson patent as an interfering patent. Such suit also would be brought in the District Court of the United States for the Southern District of California,

at Los Angeles, and either of these suits would be heard upon the issues framed and the testimony produced upon behalf of the parties, and the court would give its independent judgment upon the record thus made in such suit and the final judgment of the Patent Office in said interference proceeding would not be in any sense *res adjudicata* or even controlling to any degree *unless the record was the same.* It would be necessary for the party who wished to use such final judgment in the interference proceeding upon any claim that such final judgment should be followed to show that the record in the interference proceeding and the record in the court trial were the same.

The suit under section 4915 is to compel the Commissioner of Patents to grant a patent. In the case at bar the Bole patent has issued, and issued without any interference proceeding. The Patent Office hears and determines an interference proceeding upon depositions without ever seeing the witnesses. The trial court in this case observed the witnesses, asked questions of many of them and determined this case upon a different record with the testimony of witnesses whose depositions were not taken in the Patent Office interference, and has rendered its judgment *before* there has been any final determination of the interference proceeding. There was no final determination to be *res adjudicata* or controlling.

For each of these reasons the trial court was not bound by the opinion of the Examiner of Interferences. In this case the complainants entered the court with a *prima facie* case. The grant of the patent to com-

plainants raises a *prima facie* presumption that Mr. Bole was the original, first and sole inventor. The situation is entirely different from that in Morgan v. Daniels, which was a suit to compel the issuance of the patent under Section 4915 in a case where no patent had issued and no presumption had arisen by the issuance of the patent as to who was the prior inventor.

At the time this suit was brought the Bole patent had issued. It was presumptively valid. There had been no adjudication by any tribunal that Mr. Bole was not the inventor. The defendants were using the invention patented to Mr. Bole and Mr. Double, the complainants herein. To prevent such unlawful use or infringement the law gave complainants the right to bring suit to prohibit the continuance of such infringement. If they had a right to bring such suit they certainly had a right to have the court hear the case and determine it. And determine it on the issues raised by the pleadings and the testimony and proofs adduced in court. The decision of the court could not be "controlled" on these issues where no final adjudication was shown. It was utterly impossible for the trial court to determine what had been submitted to the Patent Office after this case was at issue and before its trial. There has never been a final decision of the interference.

The present suit is a suit to enjoin the infringement of a patent issued by the government. The defense is that Elihu C. Wilson and not complainant, Robert E. Bole, was the inventor. The presumption of law,

arising from the issuance of the patent in suit, is that Robert E. Bole was the inventor. That there is some other kind of a proceeding still pending undetermined involving this same issue is no defense. Defendants cannot cite any statute that takes away the right of complainants to bring, or to prosecute, or to have determined, this suit. They cannot show and have not shown any final adjudication of the issues of this suit in any kind of a tribunal. It is submitted that the court was not bound to slavishly follow the opinion of the Examiner of Interferences, nor was such opinion in any manner binding or controlling upon the court, nor was the court in any position to judge what effect, if any, should be given to such an opinion (had it been final), as the record upon which such opinion was based was not before the court. So far as such record was shown or referred to it was shown to be materially different.

In appellants' brief it is asserted in several instances that the lower court erred in its rulings excluding testimony. It will be noted from the transcript that appellants reserved no exceptions whatever to any of the rulings of the court. There was no stipulation and no order that all or any of the rulings of the court excluding testimony or overruling objections should be deemed excepted to. It is submitted that under equity rule 46 in a trial in open court it is necessary for a party to reserve his exceptions to any ruling which it is desired to review on appeal. If this is correct, no question of the ruling of the trial court in excluding

testimony or in sustaining or overruling objections to questions is properly before this court for review.

In appellants' brief the oral remarks or opinion of the trial court when ordering a decree in favor of complainants are criticised because "silent with respect to the question of anticipation" no defense of anticipation was pleaded. If by this defendants mean the use of this invention in the underreamers manufactured by defendants prior to Mr. Bole filing his application for patent, it is obvious that there was nothing for the court to say upon this contention, for the court held that he was thoroughly convinced that Mr. Bole was the inventor and had disclosed the invention to Mr. Wilson.

There is no objection to a defendant pleading inconsistent defenses. The attempt, however, to maintain or prove inconsistent defenses may destroy the entire weight of the defendants' evidence or contention. If the court found that the testimony on behalf of defendants that Mr. E. C. Wilson was the originator or inventor of this invention, or that he made the sketch which he asserts to have had in his hand at the time of the alleged conference of February, 1911, was untrue, the court was certainly justified in holding that Mr. Bole had more than proven his inventorship, and no subsequent act of the defendants in making and using the invention could anticipate Mr. Bole's invention. It is not claimed that the invention was in public use or on sale more than two years prior to Mr. Bole's application. It is clear under the issues of this case and under the testimony of Mr. Willard, Mr. E. C.

Wilson, Mr. W. W. Wilson, Mr. Bole, Mr. Naphas and the other witnesses, that either Mr. Bole was the original inventor and Mr. Wilson derived his knowledge of the invention from Mr. Bole, or that Mr. E. C. Wilson was the originator, as he claims. If truth is denied to defendants' testimony that Wilson was the inventor, as he explained the invention to Mr. Bole, then there is nothing to deny Mr. Bole's inventorship and nothing to impeach his testimony that he explained the invention to Mr. Wilson. In the final analysis this is the sole issue in this case, and it is an issue of fact.

In appellants' brief appellants go outside of the record in this case and assert that the Board of Examiners-in-Chief of the United States Patent Office have affirmed the decision of the Examiner of Interferences in the Patent Office interference. This is not a part of the record in this case and not before the court. This court is called upon to review the decision of the lower court, on the record before that court. However, with due apology to this court, complainants will depart from the record to the extent of stating, what is the fact, that such interference is still pending in the United States Patent Office on appeal and has not been finally determined. On the contrary, the Commissioner of Patents has ordered that said interference be stayed and suspended pending the decision of this court. This action was taken by the Commissioner of Patents upon the motion of complainants. Such motion was based upon a certified copy of the judgment roll in this suit, including all the pleadings, the decree, a certified copy of the trial judge's decision,

a transcript of the evidence, etc. Such motion was based upon the ground that this court having personal jurisdiction of all the parties and the issue in this case being whether Robert E. Bole or Elihu C. Wilson was the inventor, the decree in this case will be *res adjudicata* between the parties; that they will have had their full day in court on such issue and that under Section 4918 of the Revised Statutes or under Section 4915 of the Revised Statutes this court would be the court which would have jurisdiction finally of such issue and that the decree in this case finally settles this issue.

It is submitted, therefore, that the decree or order appealed from was correct and should be affirmed. That complainants have conclusively proven that Robert E. Bole was the inventor and did disclose this invention to E. C .Wilson. That defendants have utterly failed to sustain the burden of proof upon them to prove the contrary.

Respectfully submitted,

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Of Counsel for Appellees.